



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker, James A.) Group Art Unit: 3711
Jorasch, Peter Kim, Geoffrey)
M. Gelman, Andrew P.) Examiner: PIERCE, William M.
Golden, Russell Pratt Sammon,)
and Norman C. Gilman) **APPEAL BRIEF**

Application No.: 09/602,869) Attorney Docket No. 99-081

Filed: June 23, 2000)

For: GAMES OF CHANCE WITH)
PLAYER-SPECIFIED ELEMENTS)

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Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed March 26, 2003 (Paper No. 12), rejecting claims 26, 27, and 38-72.

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REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 1177 High Ridge Road, Suite 128, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

No interferences or appeals are known to Appellants, Appellants' legal representative, or Appellants' assignee, that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 26-72 are pending in the present application:

- (i) Claims 26, 27, and 38-72 are finally rejected and are being appealed.
- (ii) Claims 28-37 have been withdrawn from consideration.

Claims 26, 27, 38-42, 50, 52, 56, 64-66, 70, and 72 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 26, 27, and 38-72 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,816,575 issued to Keller (hereinafter "Keller").

Claims 26, 27, 38, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,110,129 issued to Alvarez (hereinafter "Alvarez").

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of Claims 26, 27, and 38-72.

SUMMARY OF INVENTION

One aspect of the invention includes a method of administering a game. The game involves at least a first random outcome and a second random outcome combined according to game rules to produce a game outcome. For example, a game such as blackjack includes two random outcomes (e.g., the dealer's hand and the player's hand) which produce a game outcome (e.g., whether the player or dealer has won).

The method includes receiving a player request for a specific entry (e.g., a specific score such as 18) instead of one of the random outcomes (e.g., a hand the player would be dealt, a hand the dealer would be dealt). The specific entry is selected from a finite set of possibilities not determined by chance. The specific entry affects a likelihood of a game outcome. The method also includes combining the specific entry and the remaining one of the random outcomes according to the game rules to determine a game outcome. The method may be applied to any game of chance having two or more random outcomes, including, for example, blackjack, poker, a slot machine game, twenty-one, craps, and pai gow. [See, e.g., Specification, page 2, line 30 to page 5, line 16].

According to one aspect of the present invention applied as a modification of blackjack, a player can request a specific entry (e.g., a specific score) to replace either the player's hand or the dealer's hand. For example, the player may request a score of eighteen to be compared against the dealer's hand, or may request that the dealer's hand be replaced with a score of eighteen and that the player's hand be compared against that score in determining a winner of the game. [See, e.g., Specification, page 3, lines 7-15].

ISSUES

Whether Claims **26, 27, and 38-72** are unpatentable under 35 U.S.C. § 102(b) (hereinafter “§ 102(b)”) as being anticipated by Keller.

Whether Claims **26, 27, 38, and 40** are unpatentable under § 102(b) as being anticipated by Alvarez.

Whether Claims **26, 27, 38-42, 50, 52, 56, 64-66, 70, and 72** are unpatentable under 35 U.S.C. § 112, second paragraph (hereinafter “§ 112 (2)”), as being indefinite.

GROUPING OF CLAIMS

The claims in different groups do not stand and fall together.

Appellants group the pending claims as follows:

GROUP I:	Claim 26
GROUP II:	Claim 27
GROUP III:	Claims 38 and 39
GROUP IV:	Claims 40 and 41
GROUP V:	Claims 42-45 and 47-55
GROUP VI:	Claims 56-63 and 67-69
GROUP VII:	Claims 70 and 71
GROUP VIII:	Claim 72
GROUP IX:	Claim 46
GROUP X:	Claims 50 and 52
GROUP XI:	Claims 64-66

Appellants believe that claims in different groups are separately patentable, as explained in the following Arguments section.

ARGUMENTS

Summary of Arguments

First, the Examiner has not demonstrated that any claim is anticipated by the prior art of record.

Second, the Examiner has not shown that any claim is indefinite. The Examiner has failed to apply the proper standard for assessing definiteness. In fact, the standards used by the Examiner are clearly not supported by law, namely:

1. breadth is synonymous with indefiniteness
2. the phrase "depends on" is indefinite *per se*
3. a process claim must recite a "structural relationship" or "physical dependence" among recited terms
4. the origin of a term recited in a process step must be expressly explained in the claim, not just in the specification

Accordingly, the rejections are inappropriate and Appellants respectfully request that the Examiner's rejections be reversed.

Form of Appeal Brief

In the arguments herein, claim numbers are indicated in **bold**, limitations of the claims are indicated in *italics*, and the references are indicated with underlining.

In separate arguments of patentability of different Groups, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

THE REFERENCES

The references cited by the Examiner, either alone or in combination, do not disclose or suggest all of the limitations of any claim. Discussed immediately below are the only references used in rejecting the appealed claims: Keller and Alvarez.

The Keller patent

The Keller reference discloses a "type of Blackjack (21) game." In addition to "the standard betting option against the Dealer," the game allows a player a "Dealer Bust" option and several options "to make a bet on receiving at least one card from an initial two cards received by the Blackjack player equal to one of a 4 and 5, one of a 3 and 6 and a selected one of a 10, a Jack, a Queen, a King and an Ace." [Abstract; Column 4, lines 60-67].

"Throughout the Blackjack game and method of this invention, it is preferable to focus on the first two initial cards since in many cases there are no more cards dealt to the Blackjack player, than the required minimum of the two initial cards dealt by a Dealer to the Blackjack player." [Column 6, lines 46-50].

"The Bonus Hand and Dealer Breaks or Bust bets provide the Blackjack player with new emphasis and opportunity on the two most important events in a 21 game; the Blackjack player's first two cards, and the Dealer's hand." [Column 9, lines 16-20].

"A Blackjack player may also bet on the cards which Blackjack player expects will be dealt to the Blackjack player in the first two cards called the Bonus Hand." [Column 10, lines 17-20].

"The Blackjack player may also bet that the Dealer will break or bust their hand (exceed 21) during play." [Column 10, lines 32-34].

The Alvarez patent

The Alvarez reference relates to “a device for automatically selecting numbers to be entered in a lottery drawing and a pamphlet for use in playing the lottery.” [Column 2, lines 34-36]. Alvarez describes:

A number selecting device adapted to darken a predetermined amount of numbered boxes on a lottery computer game card inserted therein in accordance with a picked selection of numbers selected from a group of lucky numbers stored in a computer within the device wherein the lucky numbers are associated with a particular subject of interest to the user.... The removable game card is adapted to be inserted into the number selecting device for darkening of the boxes and thereafter into a standard lottery computer card reading machine for printing of purchased game tickets and entry of the picked set of numbers into a memory bank.

[Abstract].

Alvarez also describes how “many states have at least one lottery drawing...wherein a predetermined amount of numbers are drawn from a larger group of numbers, wherein the drawn numbers represent a winning combination.” [Column 1, lines 22-26].

1. **GROUP I**

GROUP I includes independent Claim 26.

The rejection of the claim of GROUP I is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP I.

Specifically, the Examiner has not shown that any claim of GROUP I can be deemed to be either indefinite or anticipated by the prior art of record.

1.1. **Independent Claim 26**

Independent Claim 26 is directed to a method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner.

The method comprises allowing a player to select a specific score instead of a player's hand. A dealer's hand is dealt and played. The method also comprises comparing the specific score to the dealer's hand and a predetermined point total to determine a winner of the game.

1.2. **Advantages of Independent Claim 26**

The embodiment of Claim 26 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 26 is advantageous in that it provides for *allowing a player to select a specific score instead of a player's hand*. Thus, a player of a game may be allowed to select a specific score in lieu of a hand to play. According to one example, a player may request a score of "18" to replace the player's hand and to be compared against a dealer's hand in a blackjack game. [Specification, page 3, lines 7-10]. By allowing a player to receive a specific score instead of a hand, a game played in accordance with such a provision may be more attractive to a player. "For example, a player who has been busting frequently in blackjack may be inclined to continue playing when he/she is allowed to request a specific entry in place of the player's hand, thereby completely eliminating any chance of going bust."

GROUP I

[Specification, page 16, lines 21-23; see also, page 2, lines 23-25]. Also, allowing a player to select a specific score instead of a hand may provide simpler and easier play. [Specification, page 2, lines 25-26].

In general, the method of Claim 26 is also advantageous in that it provides for *dealing and playing a dealer's hand*. Thus, the method allows for play of a game in which a hand of a dealer is dealt. In an example of a blackjack game, dealing and playing a dealer's hand would be a random outcome. [See, e.g., Specification, page 7, lines 17-18]. Thus, dealing a dealer's hand and playing the dealer's hand is advantageous in that even if a player has selected a specific score instead of a player's hand, the effect of chance on the outcome of a game may not be excluded. [See, e.g., Specification, page 7, lines 11-13].

The winners of some types of games (e.g., blackjack) may be determined based on comparison with a predetermined point total (e.g., "a twenty-one count" which if exceeded results in a "bust"). [See, e.g., Specification, page 1, lines 27-28]. The method of Claim 26 is further advantageous in that it provides for *comparing the specific score to the dealer's hand and a predetermined point value total to determine a winner of a game*. Thus, *determining a winner* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18") *selected by a player in place of a player's hand*, (b) *the dealer's hand*, and (c) *a predetermined point total*. According to some embodiments, for example, the playing of the dealer's hand may result in a score that is compared with the specific score selected by the player to determine a winner. For instance, in a game of blackjack, if the specific score is higher than the score which results from play of the dealer's hand then the game rules may prescribe that the player wins. However, if the score obtained from the dealer's hand is higher than the specific score, then the dealer wins. [See, e.g., Specification, page 20-24]. Thus, Claim 26 advantageously allows that a player may be determined to be the winner of a game based on a comparison of *a specific score (selected instead of a player's hand) to a dealer's hand and a predetermined point total*.

1.3. No Prima Facie Showing of Anticipation of the Claim of GROUP I

A reading of the rejections of the claim of GROUP I reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP I.

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc., 45 F.3d 1550 (Fed. Cir. 1995).

The elements of the claim must either be inherent or disclosed expressly in the reference. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560 (Fed. Cir. 1988).

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565 (Fed. Cir. 1986).

Further, "[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) ('The [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.' (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. An expert's conclusory testimony, unsupported by the documentary evidence, cannot supplant the requirement of anticipatory disclosure in the prior art reference itself. See Jamesbury Corp. v. Litton Indus. Prods., Inc., 756 F.2d 1556, 1563, 225

U.S.P.Q. (BNA) 253, 257-58 (Fed. Cir. 1985)". Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461 (Fed. Cir. 1997).

Also, the elements in the prior art must be arranged as they are in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226 (Fed. Cir. 1988).

1.3.1. No showing that the references suggest allowing a player to select a specific score instead of a player's hand

Some embodiments of the present invention provide for replacing either the player's hand or the dealer's hand in a game (e.g., a blackjack game) with a specific entry (e.g., a specific score). "For example, the player may request a score of 18 to be compared against the dealer's hand...." [Specification, page 3, lines 7-10].

A specific entry is a score, or set of one or more game indicia, specified by a player to replace a random outcome. [Specification, page 7, lines 6-7]. "The effect of the specific entry is to eliminate at least one random outcome and to limit, but not to exclude, the effect of chance on the outcome of the game." [Specification, page 7, lines 11-13].

Claim 26 recites a feature of *allowing a player to select a specific score instead of a player's hand* that is not disclosed by either Keller or Alvarez.

Keller requires a player's hand

Keller does not teach or suggest allowing a player to replace a random outcome with a specific score. Keller is devoid of any hint or suggestion of *allowing a player to select a specific score instead of a player's hand* (emphasis added).

In fact, Keller describes "the Blackjack player's first two cards, and the Dealer's hand" as "the two most important events in a 21 game." [Column 9, lines 18-20 (emphasis added)].

Keller even **requires** that two cards be dealt to a player. The entirety of the Keller disclosure is focused "on the first two initial cards since in many cases there are no more cards dealt to the Blackjack player, than the required minimum of the two initial cards dealt by a Dealer to the Blackjack player." [Column 6, lines 46-50 (emphasis added)]. According to

Keller, a blackjack player “expects to” be dealt an initial hand of two cards. [Column 10, lines 17-20].

Keller cannot suggest that a player may be allowed to *select a specific score instead of a player’s hand*.

Nonetheless, the Examiner asserts: “As to Keller a player is allowed to select a specific entry, such as “4+5” or “21 bet” and this entry is compared to the dealers [sic] hand to determine a winner. Keller shows a ‘side bet’ game where these wagering options are evaluated ‘instead of’ the player’s or dealer’s hand.” [Second Final Office Action, page 4].

The Examiner thus focuses inappropriately on an “evaluation” aspect of the Keller system without even asserting that Keller suggests *a selection by a player of a specific score instead of a player’s hand* (emphasis added).

Appellants note that the “side bet” options in Keller of “4+5” and “21 bet” relied on by the Examiner are resolved based on the hand of cards the player receives.

It follows that, contrary to the Examiner’s assertion, such “side bets” are evaluated against the player’s hand, not the dealer’s hand, and rather than suggesting the player would not receive a player’s hand, Keller in fact teaches (even requires) the opposite.

The Examiner also asserts: “Keller shows a player selecting a ‘specific score[.]’ on the ‘players betting palette’ and comparing that to the dealers [sic] hand (for example dealer breaks) to determine the winner of the game.” [Second Final Office Action, page 3; First Final Office Action, page 3].

Appellants dispute that “dealer breaks” suggests *a specific score*.

Also, there is nothing in Keller that would suggest that the “dealer breaks” “side bet” is *selected instead of a player’s hand*.

To the contrary, in recognizing that this “wagering option” in Keller is merely a “side bet,” the Examiner concedes that the player in the Keller system must still receive and play a player’s hand—the player is never allowed to *select a specific score instead of a player’s hand*.

The lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome

The lottery system of Alvarez does not teach or suggest *a player's hand*, much less the desirability of *allowing a player to select a specific score instead of a player's hand* (emphasis added).

The Examiner asserts, nonetheless, that *a player's hand* is "the outcome of the lottery." [Second Final Office Action, page 5]. This would equate to allowing a lottery customer to select the outcome of a lottery, which is clearly illogical.

Further, the lottery system of Alvarez does not teach *a specific score*. There is no suggestion of allowing a player to replace a random outcome, as is provided in Claim 26 by *allowing a player to select a specific score instead of a player's hand* (emphasis added). Instead, Alvarez describes a lottery system in which numbers are selected for play (automatically or by a player) and the numbers are compared against randomly drawn numbers in a conventional manner. [See "The Alvarez patent" above]. There is no suggestion that whether the numbers are selected by a player or automatically has any effect on the randomness of the game.

Nonetheless, the Examiner asserts: "Alvarez shows a specific score as being the numbers selected by the player and the dealer's hand to be the numbers selected by the lottery game." [Second Final Office Action, page 5; see also, Second Final Office Action, page 3; First Final Office Action, page 3 (asserting that Alvarez shows "allowing a player to select a specific score on a ticket")].

Applicants dispute this assertion. The selected lottery numbers in Alvarez are not a specific entry or *a specific score*. They are not specified to replace or eliminate a random outcome. [Specification, page 7, lines 6-7, 11-13].

Also, there is no suggestion in Alvarez that the selection of one number over another has any bearing on the game outcome. For instance, whether a lottery player selects "35" or "17" as a lottery pick will not affect his likelihood of winning the lottery drawing.

In contrast, a specific entry (e.g., *a specific score*) affects a likelihood of a game outcome. [Specification, page 7, lines 6-7]. For example, a blackjack player's selection of the *specific score* of "18" will affect his likelihood of winning the game under the rules of blackjack differently than if he had selected "20," or if he had elected to play a hand.

1.3.2. No showing that the references suggest comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game

Claim 26 provides for a feature of *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game* that is not disclosed by either Keller or Alvarez.

According to one blackjack example, "[i]f the score provided by the specific entry is higher than the score which results from the dealer's hand (random outcome) then the game rules prescribe that the player wins." [Specification, page 7, lines 22-24]. For instance, a non-random, *specific score* of "18" *selected by a player instead of a player's hand* is compared to a *dealer's hand* having a score of "19" and a *predetermined point total* of "21" to determine that the dealer is the winner.

Keller does not teach a specific score selected instead of a player's hand

As discussed in Section 1.3.1 above, Keller cannot teach or suggest *allowing a player to select a specific score instead of a player's hand* (emphasis added). Accordingly, Keller cannot teach or suggest *comparing a specific score that is selected instead of a player's hand to a dealer's hand to determine a winner of a game*, as generally recited in independent Claim 26.

Alvarez does not teach a specific score selected instead of a player's hand

As discussed in Section 1.3.1 above, Alvarez cannot teach or suggest *allowing a player to select a specific score instead of a player's hand* (emphasis added). Accordingly, Alvarez cannot teach or suggest *comparing a specific score that is selected instead of a player's hand to a dealer's hand to determine a winner of a game*, as generally recited in independent Claim 26.

The Examiner states that Alvarez shows "a 'predetermined point total' of 1-40 for example, allowing a player to select a specific score on a ticket 12, 'dealing and playing a dealer's hand' by the lottery computer selecting numbers and comparing this hand to a players score to determine a winner." [Second Final Office Action, page 3; First Final Office Action, page 3]. The Examiner further asserts: "the outcome of the game in Alvarez is based on the numbers selected by the player as being his specific entry of a predetermined count value usually ranging from numbers 1-40 and the dealer's score selected by the lottery." [Second Final Office Action, page 5].

Appellants do not agree with this interpretation of Alvarez. [See, Amendment & Response mailed December 13, 2002, page 7]. A pool of numbers from which a lottery player can make picks does not suggest *a predetermined point total*. It is telling that the Examiner has never provided any attempt at a rationale for why a pool of numbers would suggest *a predetermined point total* of Claim 26. Instead, the Examiner appears to be relying solely on an unstated assumption that "one number used in a game suggests any another number," regardless of what purpose *the predetermined point total* has in the recited claim.

In fact, the Examiner simply seems to be reiterating that the lottery player selects numbers from a range of 1-40. In Alvarez, the pool of numbers itself has nothing to do with determining a winner, nor, of course, is the pool ever compared to a player's selected lottery numbers to determine a winner. For instance, there is nothing in Alvarez that suggests that a number (i.e., what the Examiner asserts is a specific score, which Appellants dispute) selected from the pool of numbers 1-40 (as asserted by the Examiner), is then also compared to the pool of numbers 1-40 in determining a winner.

Thus, contrary to the Examiner's assertions, the pool of numbers from which a player may select a lottery number (e.g., 1-40) in the Alvarez lottery system cannot teach or suggest *a predetermined point total*, much less *a predetermined point total that is compared with a specific score and a dealer's hand in determining a winner*.

1.4. The Claim of GROUP I is Allowable Over the Cited References

As described above, the Examiner has failed to provide a *prima facie* showing of anticipation of the claim of GROUP I in light of either Keller or Alvarez.

In addition, as described above, neither of the references anticipates the claim of GROUP I.

In addition, the references cannot be combined in any manner that would render the claim of GROUP I obvious.

1.4.1. The references do not suggest all of the features

As discussed in Section 1.3 above, no cited reference suggests the features of:

- *allowing a player to select a specific score instead of a player's hand*
- *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game*

as recited in independent Claim 26.

Accordingly, the references, alone or in combination, cannot teach or suggest all of the features of the claim of GROUP I.

1.4.2. No motivation to combine the references

There is no suggestion in the record to make the combination or modification of the references.

Further, the references are non-analogous. Keller has nothing to do with a lottery system, as in Alvarez. Alvarez has nothing to do with a blackjack game, as in Keller.

1.5. No Prima Facie Showing of Indefiniteness of the Claim of Group I

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP I, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP I does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP I as indefinite under § 112 (2).

Instead, contrary to law, the Examiner has expressly refused to consider the definiteness of disputed claim terms in light of the Specification.

Contrary to law, the Examiner expressly equates breadth of a claim with indefiniteness.

Contrary to law, the Examiner finds the use of language in the general format of *A depends on B* to be indefinite *per se*.

The Examiner has imposed several novel and extraneous definiteness requirements that have no legal basis:

- a claim must expressly explain a particular way that a process step might be practiced; otherwise the claim language is “inferential”
- a process claim must recite a structural relationship among recited terms

1.5.1. Whether or Not the Preamble is a Claim Limitation is Irrelevant to Overcoming the Examiner’s § 112 (2) Rejection of the Claim of Group I

The Examiner has extensively reviewed language in the preamble of Claim 26 for compliance with § 112 (2), and has found language in the preamble to be indefinite. [See, e.g., Second Final Office Action, pages 2, 4]. If such a finding were sustainable, which Appellants dispute, it might have been necessary to determine if the preamble in fact limited the claim, in order to determine whether the preamble language could a rejection under § 112 (2).

The Examiner’s findings with respect to the preamble are not sustainable. Appellants’ arguments with respect to the Examiner’s reasons for finding § 112 (2) indefinite preclude any need to determine whether the preamble does or does not actually include a claim limitation.

Specifically, even if the preamble does include a claim limitation, Appellants establish herein that the preamble language does not provide any basis for an indefiniteness rejection under § 112 (2). On the other hand, if the preamble does not include a limitation, then the clarity of the preamble is not an issue with respect to § 112 (2).

1.5.2. The Proper Legal Standard under 35 U.S.C. § 112, Second Paragraph

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The Federal Circuit has explained that the second paragraph of § 112 contains two requirements: First, a claim must set forth what the applicant regards as his invention; and second, it must do so with sufficient particularity and distinctness, i.e., the claim must be sufficiently "definite." Allen Eng'g Corp. v. Bartell Indus., 299 F.3d 1336, 1348 (Fed. Cir. 2002) (citing Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377 (Fed. Cir. 2000)). See also, MPEP § 2171.

"During the prosecution of a patent application, a claim's compliance with both portions of 35 U.S.C. section 112, paragraph 2, may be analyzed by consideration of evidence beyond the patent specification, including an inventor's statements to the Patent and Trademark Office ('PTO')." Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377-1378 (Fed. Cir. 2000). See also, In re Conley, 490 F.2d 972, 976 (C.C.P.A 1974) (noting that the phrase "which the applicant regards as his invention" in the second portion of § 112 (2) "has been relied upon in cases where some material submitted by applicant, other than his specification, shows that a claim does not correspond in scope with what he regards as his invention.").

With respect to the first requirement, the subject matter set out in a claim must be presumed, in the absence of evidence to the contrary, to be that "which the applicant regards as his invention." In re Moore, 439 F.2d 1232, 1235 (C.C.P.A 1971). See also, MPEP § 2172.

With respect to the second requirement: "If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993); see also, S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001). The claims need set out and circumscribe a particular area with only a reasonable degree of precision and particularity. In re Moore, 58 C.C.P.A. 1042, 1046-1047 (C.C.P.A. 1971). See also, MPEP § 2173.02 ("Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.").

Breadth is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693 (C.C.P.A. 1971); see also, In re Robins, 429 F.2d 452, 458 (C.C.P.A. 1970) (finding claims definite under § 112 (2) even though "[g]iving the language its broadest possible meaning...the breadth of the claims insofar as the catalyst is concerned is indeed immense. However, 'Breadth is not indefiniteness.'" (citation omitted, emphasis added)). See also, MPEP § 2173.04.

The ability of an Examiner to enumerate examples encompassed by claim language points up the weakness of the Examiner's indefiniteness argument that the meaning of the language cannot be ascertained with any degree of reliability. See, In re Robins, 429 F.2d at 458.

"In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims." Ex parte Wu, 10 USPQ2d 2031, 2033 (Board of Pat. Appeals and Interferences 1989).

Thus, in determining whether a claim is sufficiently definite, the Examiner must analyze whether one skilled in the art would understand the bounds of the claim when read in light of the specification. See Allen Eng'g Corp. v. Bartell Indus., 299 F.3d 1336, 1348 (Fed. Cir. 2002) (citing Personalized Media Communs., L.L.C. v. ITC, 161 F.3d 696, 705 (Fed. Cir. 1998)).

There is no requirement under § 112, second paragraph, that a claim must be “a self-contained explanation of every step. That is not the role of claims. The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant.” S3 Inc. v. nVIDIA Corp., 259 F.3d 1364, 1369 (Fed. Cir. 2001) (dismissing the district court’s objection “that the claims are not self-contained in that they do not explain that ‘video display information is produced by the controller’”).

1.5.3. Claim 26 Meets the Proper Legal Standard for Definiteness

26. (PREVIOUSLY PRESENTED) A method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner, comprising:

allowing a player to select a specific score instead of a player’s hand;

dealing and playing a dealer’s hand; and

comparing the specific score to the dealer’s hand and the predetermined point total to determine a winner of the game.

Claim 26 complies with both of the requirements of § 112, second paragraph: It (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently “definite”).

With respect to the first requirement, Appellants affirmatively state that Claim 26 is consonant with one or more aspects their invention. There is no evidence of record that Claim 26 encompasses anything other than what Appellants regard as their invention. The Examiner has made no such assertion. Nonetheless, various comments by the Examiner (particularly with respect to the preamble and claim language that is allegedly “inferential”) compel Appellants to address the possibility that the Examiner believes that Claim 26 encompasses more than what Appellants regard as their invention. See discussion in Section 1.5.10 below.

With respect to the second requirement, the meaning of the language of Claim 26 meets the threshold requirement of being reasonably clear to one having ordinary skill in the art when considered in light of the Specification. The language is plain on its face. If this were not the case, which Appellants dispute, any lack of clarity is easily resolved by reference to the Specification, as required by the proper legal analysis.

Some embodiments of the present invention provide for replacing either the player's hand or the dealer's hand in a game (e.g., a blackjack game) with a specific entry (e.g., a specific score). "For example, the player may request a score of 18 to be compared against the dealer's hand...." [Specification, page 3, lines 7-10]. Thus, Claim 26 *allows a player to select a specific score instead of a player's hand*. A specific entry is a score, or set of one or more game indicia, specified by a player to replace a random outcome. [Specification, page 7, lines 6-7]. "The effect of the specific entry is to eliminate at least one random outcome and to limit, but not to exclude, the effect of chance on the outcome of the game." [Specification, page 7, lines 11-13].

According to one aspect of the present invention, a player can request a specific entry (e.g., a specific score) to replace the player's hand. For example, the player may request a score of eighteen to be compared against the dealer's hand. [See, e.g., Specification, page 3, lines 7-15]. According to one blackjack example, "[i]f the score provided by the specific entry is higher than the score which results from the dealer's hand (random outcome) then the game rules prescribe that the player wins." [Specification, page 7, lines 22-24]. For instance, a *specific score* of "19" *selected by a player instead of a player's hand* is compared to a *dealer's hand* (e.g., having a determined point score of "18") and a *predetermined point total* of "21" to determine that the player is the winner. Thus, Claim 26 provides for *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game*.

Appellants note that the terminology was definite enough for the Examiner to interpret the claims and find cause for a restriction of Claims 26 and 27. [First Non-Final Office Action mailed September 28, 2001]. The terminology was also definite enough for the Examiner to

interpret the claims and find cause to reject those claims as anticipated by asserted prior art in three subsequent Office Actions.

The disputed language, and the Examiner's reasons for finding it indefinite, are discussed in detail herein. In summary, the Examiner has not provided any finding or legal basis that would support the rejection of Claim 26 under § 112 (2).

1.5.4. Appellants' Understanding of the Standards Applied by the Examiner to GROUP I

The claim of GROUP I is rejected by the Examiner under § 112 (2). Appellants' understanding of the standards used by the Examiner in rejecting the claim of GROUP I and the specific language in dispute are discussed below.

The novel standards and analysis established by the Examiner have no legal basis.

The Examiner's Breadth is Indefiniteness Standard

The Examiner finds that Claim 26 includes language that "is so broad as to encompasses [sic] everything under the sun...." [Examiner's Answer, page 4 (emphasis added)].

The Examiner also finds that language of Claim 26 "falls way short of limiting the claim to a Blackjack type game. In fact, since most games 'depend in part' upon a predetermined point total, the limitation is considered so broad as to have little affect on limiting the scope of the claim." [Second Final Office Action, page 2 (emphasis added)].

The Examiner is thus rejecting Claim 26 for indefiniteness merely because of its purported breadth of scope (hereinafter the "Examiner's Breadth is Indefiniteness Standard").

The Examiner's *per se* Use of "Depends" Standard

The Examiner asserts: "Something the [sic, that?] 'depends' on something is so broad as to encompasses [sic] everything under the sun when considered in argument, especially when one follows this with 'depends at least in part'" (hereinafter "the Examiner's *per se* Use of 'Depends' Standard). [Second Final Office Action, page 4]. Appellants' best understanding

is that the Examiner's *per se* Use of "Depends" Standard prohibits any claim language of the form *A depends on B* or *A depends at least in part on B* because it is *per se* indefinite or is "so broad as to [encompass] everything under the sun."

The Examiner's Inferential Standard

The Examiner has established a new standard for definiteness (hereinafter "the Examiner's Inferential Standard") by which Appellants' failure to explicitly recite any purportedly "inferred" process steps renders Claim 26 indefinite: "Hence, one reading the claims should not have guess [sic] as to whether or not certain steps that are alluded to have or have not occurred. This speculation required renders the metes and bounds of the claims in question." [Second Final Office Action, page 4].

The Examiner also suggested, "that a Jepson format be used to remove inferential [sic] in unclear language" in Claim 26. [Second Final Office Action, page 2; Second Non-Final Office Action mailed February 27, 2002, page 2; see also Examiner's Interview Summary mailed May 29, 2002].

The Examiner found that each of the steps of the claim of GROUP I included one or more terms that the Examiner found indefinite based on the Examiner's Inferential Standard. These steps and terms are discussed in further detail in Section 1.5.5 below.

The Examiner's Structural Relationship Standard

According to one standard used by the Examiner (hereinafter "the Examiner's Structural Relationship Standard"): "[A]pplicant has [sic] merely amended using the alternative word 'depends' which does nothing to correct the indefiniteness.... The structural relationship of how steps or elements are related must be positively set forth." [Second Final Office Action, page 4].

As understood by Appellants, the Examiner's Structural Relationship Standard requires that a structural relationship must be expressly defined between any terms included in a process claim.

The asserted failure of Claim 26 to comply with the Examiner's novel and baseless definiteness requirements form the grounds for the rejection of Claim 26 under § 112 (2). To the extent these standards depart from the requisite and proper legal analysis, they cannot support a rejection under § 112 (2).

1.5.5. The Examiner's Refusal to Consider the Specification in Determining Claim Definiteness is Contrary to Law

The indefiniteness rejection of the Claim of GROUP I is flawed and is contrary to law.

There is no evidence in the record that the Examiner has ever considered the definiteness of any language of any claim rejected under § 112 (2) in light of the Specification, as required by law. See, Allen Eng'g Corp., 299 F.3d at 1348; S3 Inc., 259 F.3d at 1367; Ex parte Wu, 10 USPQ2d at 2033. See also, MPEP § 2173.02.

Further, the Examiner admits that the definiteness of disputed language in Claim 26 was not considered in light of the Specification.

In the Amendment & Response mailed December 13, 2002, Appellants stated that with respect to Claim 26 although "there is no requirement that Applicants state how...the dealer's hand is compared," various examples of how the dealer's hand is compared are set forth in the Specification. [page 4].

In response, the Examiner asserted that any examples set forth in the Specification do not "render the claim definite" because "limitations appearing in the specification but not recited in the claim are not recited into the claim." [Second Final Office Action, page 4 (citing In re Prater, 415 F.2d 1393, 1404-05 (C.C.P.A 1969))].

Accordingly, Appellants understand that in analyzing the definiteness of Claim 26 the Examiner has refused to consider any of the allegedly unclear language in light of the Specification.

The Examiner's express refusal to consider the Specification in determining definiteness and his assertion that a written description cannot render claim language definite are clearly contrary to law. See, e.g., Personalized Media, 161 F.3d at 705 (finding that the

written description of the specification was sufficient to inform one skilled in the art of the meaning of the claim language “digital detector.”).

Prater cannot excuse the Examiner’s failure to consider the Specification.

The Examiner has misread and misapplied the cited portion of Prater. The Prater prohibition against importing limitations into a claim has nothing to do with how compliance with § 112 (2) is determined. 415 F.2d at 1404-05. In Prater, the appellants sought to have a claim interpreted as being limited to a “machine-implemented” embodiment disclosed in the Specification (in order to avoid a rejection under 35 U.S.C. § 101). The court found that in making their argument for a narrower scope, the appellants had effectively admitted that the claim covered subject matter for which they were not seeking patent coverage. Accordingly, the court found that the claim failed to comply with § 112 (2) because the claim read on subject matter “beyond that which ‘applicant regards as his invention.’” 415 F.2d at 1403-04.

Thus, clarity of language (the second requirement of § 112 (2), as discussed in Section 1.5.2 above) was not even at issue in Prater. Instead, the claim was rejected under § 112 (2) because the appellants were not claiming what they regarded as their invention (the first requirement).

Thus, Prater does not excuse the Examiner’s refusal to consider examples in the Specification when reviewing Claim 26 for a reasonable degree of precision and particularity.

Accordingly, the Examiner’s analysis of the definiteness of Claim 26 departs from the requisite and proper analysis under § 112 (2), which requires that a claim be read in light of the Specification.

1.5.6. The Examiner's Breadth is Indefiniteness Standard Cannot Support a Rejection under § 112 (2)

As best understood by Appellants, the Examiner finds the preamble of Claim 26 is indefinite under the clearly erroneous Breadth is Indefiniteness Standard. [Second Final Action, pages 2, 4].

The preamble of Claim 26, in relevant part, reads as follows: *A method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner....*

The Examiner states that the language of the preamble "encompasses everything under the sun" and "falls way short of limiting the claim to a Blackjack type game. In fact, since most games 'depend in part' upon a predetermined point total, the limitation is considered so broad as to have little affect on limiting the scope of the claim." [Second Final Action, pages 2, 4].

The Examiner also contends that it is "unclear" whether Claim 26 is limited "merely to games such as blackjack. One could question whether or not is [sic] includes Baccarat. Even games such as bridge depend upon a 'predetermined point total'. Arguably one would have to question whether or not this claim would cover such a game." [Second Final Office Action, page 4].

Based on these findings, the Examiner asserts that the preamble is indefinite under § 112 (2). [Second Final Office Action, page 4 (referring to "the indefiniteness of such language")].

Accordingly, the sole basis for finding that the preamble language is indefinite is because the Examiner believes the language is "so broad" that it is "unclear" or would cause one "to question" its scope. In other words, the Examiner equates breadth with indefiniteness.

The Examiner's Breadth is Indefiniteness Standard is clearly contrary to law. Breadth cannot be equated with indefiniteness, even if the claim breadth is "immense." See, Miller, 441 F.2d at 693; Robins, 429 F.2d at 458.

The Examiner fails to appreciate that to determine that language is "so broad" (as he has done) is to have necessarily determined its "metes and bounds." One who is able to make a

determination of scope (whether narrow or "so broad") cannot then turn around and say the claim scope is "unclear."

The Examiner does not indicate that any of the particular words *hand*, *player*, *game*, *game outcome* or *predetermined point total* are unclear or would not be understood by those having ordinary skill in the art. As noted in the Specification, the winners of some types of games (e.g., blackjack) may be determined based on comparison with a predetermined point total (e.g., "a twenty-one count" which if exceeded results in a "bust"). [See, e.g., Specification, page 1, lines 27-28].

The disputed language thus indicates, with at least a reasonable degree of precision, that the intended field of use involves play of a type of *game* that has a *game outcome that depends at least in part on a predetermined point total*.

The Specification certainly does not obfuscate the plain language of the claim; the Examiner does not assert otherwise. In fact, as discussed in Section 1.5.5 above, the Examiner refused to consider the Specification at all in considering claim definiteness.

In fact, contrary to the Examiner's assertion that the preamble language is unpatentably imprecise, the Examiner admits that he has been able to discern a particular meaning. Specifically, the Examiner has indicated at least three types of games having outcomes of the sort that he believes are reasonably encompassed by the preamble language: "bridge," "Baccarat," and "blackjack." [Second Final Office Action, page 4].

The ability of the Examiner to enumerate three examples that he believes are encompassed by the preamble language fatally undermines the Examiner's argument that the meaning or scope of that language is unclear. See, Robins, 429 F.2d at 458.

The Examiner's standard is contrary to law. Furthermore, the findings with respect to the uncertainty of the preamble language are contradicted by the Examiner's own admissions and thus cannot be the basis for a rejection under § 112 (2).

1.5.7. The Examiner's *per se* Use of "Depends" Standard Cannot Support a Rejection under § 112 (2)

The Examiner finds that language in the preamble, *a game outcome that depends at least in part on a predetermined point total* (emphasis added), renders Claim 26 indefinite under the Examiner's *per se* Use of "Depends" Standard.

The Examiner's standard and the findings with respect to this language are contrary to law and cannot be the basis for a rejection under § 112 (2).

To the extent that the Examiner objects to the use of the "depends" because it purportedly "encompasses everything," the Examiner's *per se* Use of "Depends" Standard is merely a variation of the Examiner's Breadth is Indefiniteness Standard. As discussed in Section 1.5.6 above, breadth is not to be equated with indefiniteness.

Although it is not clear, the Examiner appears to be objecting to on the mere use of *depends* or *depends at least in part on* as a basis for finding that the preamble is unpatentably unclear: "Something the [sic] 'depends' on something is so broad as to encompasses [sic] everything under the sun when considered in argument, especially when one follows this with 'depends at least in part.' [Second Final Office Action, page 4].

There is no legal basis for any novel *per se* rule for indefiniteness prohibiting the mere use of "depends." The Examiner does not indicate any authority for this contention.

Any assertion that language in the general form *A depends at least in part on B* is indefinite because it "encompasses everything" strains credulity. Such an argument must consciously and indefensibly ignore what *A* and *B* might describe. Accordingly, the Examiner's *per se* Use of "Depends" Standard cannot be the basis for a rejection under § 112 (2).

Further, as discussed in Section 1.5.6 above, the meaning of the disputed preamble language would be reasonably clear to one of ordinary skill in the art.

The mere use of "depends" is not a proper basis for rejecting Claim 26 under § 112 (2). To the extent the Examiner relied upon such a baseless *per se* rule, the rejection of Claim 26 cannot stand.

1.5.8. The Examiner's Inferential Standard Cannot Support a Rejection under § 112 (2)

As best understood by Appellants', every step of the claim of GROUP I includes language that purportedly fails the Examiner's Inferential Standard.

The language of Claim 26 is definite under § 112 (2). The Examiner's Inferential Standard has no legal basis, nor do the Examiner's findings that certain terms are "inferential" support any rejection under § 112 (2).

Under the Examiner's Inferential Standard, a claim should be rejected if "one reading the claims [has to] guess as to whether or not certain steps that are alluded to have or have not occurred." For the Examiner, this "speculation" is fatal to patentability. [Second Final Office Action, page 4].

According to the Examiner: "for the step of a claim to be definite, the physical steps required to be performed must be clear." The Examiner asserts that various terms and steps recited in Claim 26 "infer steps have taken place" that are not also explicitly included in the claim. [Second Final Office Action, page 4]. According to the Examiner, this creates "a scope of claim problem where one would be required to guess as to the steps to play the game that fall before, between and after the steps of 'allowing', 'dealing' and 'comparing'." [Second Final Office Action, page 2].

This last statement is perhaps the most informative in understanding why the Examiner objects so strongly to the alleged lack of detail in Claim 26: The Examiner appears convinced that Appellants must claim in more detail how to play a very specific game. The Examiner is thus very concerned that more detailed steps are not provided (e.g., clarifying what a hand is, how a hand dealt, how an outcome is depends on a point total, how a player actually selects a specific score), and, as discussed in Section 1.5.6 above, is very uncomfortable with the purported scope of Claim 26. The Examiner has repeatedly suggested that Appellants redraft Claim 26 as in a Jepson claim format in order to avoid the alleged problem with "inferential" language. [Second Final Office Action, page 2; Second Non-Final Office Action mailed February 27, 2002, page 2; see also Examiner's Interview Summary mailed May 29, 2002].

The Examiner's concern is misguided and his findings provide no basis for a rejection under § 112 (2). First, it is the role of the disclosure, not the claims, to provide a description of and to enable the invention. The Examiner is effectively asserting that in order to comply with § 112 (2), Claim 26 must include a more detailed example of each of the claim steps. There is no requirement under § 112 (2), however, that a claim must be "a self-contained explanation of every step. That is not the role of claims. The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant." S3 Inc., 259 F.3d at 1369. There is no legal basis for a rejection under § 112 (2) merely because a claim fails to have the level of detail desired by the Examiner.

Thus, contrary to the Examiner's assertion, there is no requirement to recite "the physical steps required to be performed." Appellants cannot state more plainly that if a step is not recited, it is not required.

To the extent the Examiner intended to reject Claim 26 under the first paragraph of § 112 as not being enabled, the Examiner has never indicated why one having ordinary skill in the art would be unable to make or use the claimed invention in light of the Specification. See also, discussion in Section 1.5.10 below. To the contrary, as discussed in Section 1.5.5 above, the Examiner has apparently refused to consider the disclosure in reviewing the patentability of Claim 26.

Second, as discussed in Section 1.5.10 below, Appellants are not limited by the disclosure to claiming a specific, detailed game process. As described in the Specification, at least one of the broader aspects of Appellants' invention provides generally for a way of playing many types of games, and in some aspects Appellants' invention may be implemented as a modification of a known game (e.g., blackjack). [Specification, page 2, line 30 to page 3, line 13].

Further, the Examiner also identified each of the Alvarez and Keller references as teaching every feature of every claimed step. [Second Final Office Action, page 3 (rejecting Claim 26 as anticipated by each reference)]. In some instances, as discussed below, the Examiner spontaneously provided examples he alleges are encompassed by disputed claim

language. Regardless of whether the Examiner's interpretations of the steps and / or the references are correct, the examples of the subject matter proffered by the Examiner clearly contradict the Examiner's allegation that one having ordinary skill in the art would have to "speculate" as to how to practice the claimed invention. This critically undermines any argument the language is unclear. Robins, 429 F.2d at 458. Again, the Examiner fails to appreciate that the ability of one of skill in the art to conceive of many embodiments encompassed by particular language does not leave one "at a loss" as to claim scope.

The Examiner's improper treatment of each of the steps of Claim 26 under the Examiner's Inferential Standard is now discussed in detail.

Step A: *allowing a player to select a specific score instead of a player's hand.*

The Examiner asserts that *a specific score* and *a player's hand* are "inferential since a score for a player's hand and selecting a players [sic] hand has [sic] not been previously recited." [Second Final Office Action, page 2]. As stated by the Examiner in another way: "They further infer steps have taken place such as a player being offered a 'players [sic] hand' or that he has the option of playing a 'players [sic] hand' in the alternative to selecting a specific score." [Second Final Office Action, page 4].

Appellants' best understanding is that under the Examiner's Inferential Standard, a step generally directed to *allowing a player to select A instead of B* is indefinite unless *A* and *B* have also been explicitly "offered" to the player in a required preceding step.

Alternatively, or in addition, the Examiner may be requiring that a particular way of generating *a player's hand* and / or a particular way of determining *a specific score* be explicitly recited in the claim, but this is not entirely clear to Appellants.

There is no *per se* rule about "inferential" recitation of subject matter, and especially not with respect to subject matter recited in describing a step of a process claim. The Examiner's reasons for objecting to the clear language of this step are without basis in law and

have nothing to do with clarity of meaning. By analogy, the Examiner would have found a claimed step of "hanging a picture on a wall" to be indefinite if the picture and wall, despite their plain meaning to those skilled in the art, were not "previously recited" and their origins satisfactorily defined.

Appellants are under no obligation here to explain in the claim how the step of *allowing* may take place, what *a player's hand* is, or how the player may *select a specific score*. There is no requirement under § 112 (2) that Claim 26 must be "a self-contained explanation" of what the step of *allowing* may entail. "That is not the role of claims." S3 Inc., 259 F.3d at 1369.

Further, if there were any uncertainty as to the plain meaning of the language to one having ordinary skill in the art, which Appellants dispute, it would easily be resolved by consideration of the disclosure, which, as discussed in Section 1.5.5 above, the Examiner has not done. For example, the Specification at page 3 describes an exemplary process in which a player is allowed to request a particular score ("18") to replace the player's hand; the score may be represented by a game piece. [lines 7-15].

The Examiner also identified each of the Alvarez and Keller references as teaching the claimed step. [Second Final Office Action, page 3 (rejecting Claim 26 as anticipated by each reference)]. This critically undermines any argument the language is unclear to one having ordinary skill in the art. Robins, 429 F.2d at 458.

In summary, the recited step of *allowing a player to select a specific score instead of a player's hand* sets out and circumscribes particular subject matter with a reasonable degree of precision and particularity. The disputed language cannot support a rejection under § 112 (2).

Step B: *dealing and playing a dealer's hand.*

The Examiner asserts: "The steps required by 'playing a dealer's hand' are inferential." [Second Final Office Action, page 2].

Merely "playing a dealer's hand" for example leaves one at a loss as to what must physically done [sic] according to the claim. While one knows that in blackjack, for example, the steps required for dealing a dealers [sic] hand requires a one card

face up and one card face down, these steps cannot be inferred to be included in the claim.

[Second Final Office Action, page 4].

Thus, Appellants' best understanding is that under the Examiner's Inferential Standard, the scope of *dealing and playing a dealer's hand* is indefinite because purported "steps required" for a dealer's hand to be played and dealt are not included in Claim 26.

In fact, no such steps are required to practice Claim 26, and therefore Appellants are not required to recite them.

Appellants note that all that is "required to be performed" in the method of Claim 26 is sufficiently clear from the disputed language of the step itself. Appellants claim that a dealer's hand is dealt and that the dealer's hand is played. The dealer's hand is compared to the specific score to determine the winner of the game, but the manner in which the dealer's hand is dealt and / or played is not essential to the practice of the method of Claim 26. Accordingly, a further explanation of how the step of *dealing and playing a dealer's hand* may be performed is not required for definiteness.

There is no requirement under § 112 (2) that Claim 26 must be "a self-contained explanation" of what *dealing and playing a dealer's hand* may entail. "That is not the role of claims." S3 Inc., 259 F.3d at 1369.

Appellants agree that the process step is not expressly limited to the detailed dealing process described by the Examiner. That is not relevant to a finding of indefiniteness under § 112 (2).

If the Examiner is simply arguing that one having ordinary skill would read the step as covering many different ways of *dealing and playing a dealer's hand*, then the Examiner's objection to this step is merely that it is too broad. As discussed above in Section 1.5.6 above, mere breadth cannot be equated with indefiniteness.

Appellants do not believe that the Examiner is actually asserting that any of the specific language used in the step would be unclear to one having ordinary skill in the art. The Examiner does not assert, for example, that any word is unfamiliar, would contradict ordinary usage, or is an objectionable term of degree (e.g., "about," "substantially").

To the contrary, in examining Claim 26, the Examiner readily conceived of one example of *dealing and playing a dealer's hand* that is related to blackjack. [Second Final Office Action, page 4]. The Examiner's detailed example of how the step might be practiced (e.g., as "in blackjack") belies any argument that the language is indefinite. Rather than being "at a loss," the Examiner was able to conceive of this "blackjack" example.

The Examiner also identified each of the Alvarez and Keller references as teaching the claimed step. [Second Final Office Action, page 3 (rejecting Claim 26 as anticipated by each reference)]. Regardless of whether the Examiner's interpretations of the step and / or the references are correct, the examples of the subject matter proffered by the Examiner clearly contradict the Examiner's allegation that one having ordinary skill in the art would be "at a loss" as to how to practice the claimed invention. This critically undermines any argument the language is unclear. Robins, 429 F.2d at 458. Again, the Examiner fails to appreciate that the ability of one of skill in the art to conceive of many embodiments encompassed by particular language does not leave one "at a loss" as to claim scope.

If, on the other hand, the Examiner intended to reject Claim 26 for failing to have a disclosure that would enable one having ordinary skill to determine what must be done to make or use the invention claimed in Claim 26, this unidentified basis for rejection is addressed briefly in Section 1.5.10 below.

In summary, the recited step of *dealing and playing a dealer's hand* sets out and circumscribes particular subject matter with a reasonable degree of precision and particularity. The disputed language cannot support a rejection under § 112 (2).

Step C: *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game.*

The Examiner asserts that *a dealer's hand* is "inferential since how [it] can be compared is not set forth." [Second Final Office Action, page 2]. The Examiner further asserts:

[H]ow a "dealer's hand" is considered to have a "score" must be inferred in order to compare it to determine a winner. More definitely the sum of the indicia on the

cards dealt to the dealer are compared to the specific number selected by the player to be his final "score".

[Second Final Office Action, page 4]. It is not clear if the latter statement is directed to Claim 26, which does not recite a "score" of *a dealer's hand*.

Nevertheless, Appellants' best understanding is that under the Examiner's Inferential Standard, Appellants must explicitly recite at least one way one might practice the step of *comparing the specific score to the dealer's hand*.

There is no requirement under § 112 (2) that Claim 26 must be "a self-contained explanation" of what *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game* may entail. "That is not the role of claims." S3 Inc., 259 F.3d at 1369.

Again, the Examiner appears to object merely on the basis that the recited step might encompass many different embodiments—it is broad. The Examiner simply insists that Appellants claim a specific game "[m]ore definitely." Breadth is not to be equated with indefiniteness.

The Examiner in no way supports a finding that one having ordinary skill would be unable to determine what Appellants mean by *specific score* or *comparing of a specific score to a dealer's hand*. To the contrary, the Examiner describes a particular way that a score for *a dealer's hand* might be determined for comparison to the *specific score to determine a winner*. [Second Final Office Action, page 4].

In addition, the Examiner also identified each of the Alvarez and Keller references as teaching the claimed step. [Second Final Office Action, page 3 (rejecting Claim 26 as anticipated by each reference)]. The enumeration of several examples critically undermines any argument the language is unclear to one having ordinary skill in the art. Robins, 429 F.2d at 458.

The Examiner's stubborn insistence that Appellants expressly claim a particular way of performing the steps of Claim 26 cannot support a finding that Claim 26 is indefinite under § 112 (2). To the contrary, the Examiner's ready ability to suggest examples that would be

covered by Claim 26 undermines any argument that one having ordinary skill in the art would have difficulty in discerning the scope of the claimed subject matter.

In summary, the recited step of *comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game* sets out and circumscribes particular subject matter with a reasonable degree of precision and particularity. The disputed language cannot support a rejection under § 112 (2).

Accordingly, none of the disputed language of Claim 26 is proper grounds for a rejection under § 112 (2).

1.5.9. The Examiner's Structural Relationship Standard Cannot Support a Rejection under § 112 (2)

The Examiner's novel Structural Relationship Standard requires that any terms, including language in the preamble of a process claim, recite a structural relationship in order for the language to be definite. This new standard requiring "structure" or "physical" dependence is confusing and cannot have a basis in law.

Appellants' best understanding is that under the Examiner's Structural Relationship Standard, Claim 26 is indefinite because the preamble does not specify a "physical" or "structural" relationship between *a game having a game outcome* and *a predetermined point total*.

For example, the Examiner asserts: "[A]pplicant has [sic] merely amended using the alternative word 'depends' which does nothing to correct the indefiniteness.... The structural relationship of how steps or elements are related must be positively set forth." [Second Final Office Action, page 4].

The Examiner also asserts it is "unclear" how "a game is [sic] physically 'depends at least in part on a predetermined point total.'" [Second Final Office Action, page 2].

This proposed requirement that "physical" or "structural" dependence between *a game* (or *game outcome*) and *a point total* is necessary to provide definiteness to the claim language has no legal basis.

All that is required for definiteness under § 112 (2) is that the language reasonably apprise one of ordinary skill in the art as to the scope of the claim: “§ 112 demands no more.” Miles Laboratories, 997 F.2d at 875. Thus, while it might be true that with respect to some types of inventions, a failure to indicate a structural relationship between physical elements may make the scope unpatentably unclear, a “structural relationship” is not a requirement. It is certainly not a requirement for a process claim (much less its preamble).

As discussed in Section 1.5.6 above, one having ordinary skill in the art would the meaning of a *game having an outcome that depends at least in part on a predetermined point total* reasonably clear (despite the purported absence of a defined “structural relationship”).

Accordingly, Appellants’ failure to recite a “structural relationship” or indicate “physical” dependence between a game and a point total is not a proper basis for rejecting Claim 26 under § 112 (2). To the extent the Examiner relied upon such a baseless standard, the rejection of Claim 26 cannot stand.

1.5.10. Claim 26 is Not Unduly Broad

The Examiner has made numerous assertions as to the breadth of language in the preamble of Claim 26. See discussion in Section 1.5.6 above. The Examiner has also asserted that language of Claim 26 is improperly unclear because some of it is “inferential.”

Based on numerous references made to “indefiniteness” and “unclear” scope, Appellants presume that the Examiner rejected Claim 26 under § 112 (2) for lack of definiteness only. Nonetheless, Appellants feel compelled to address other possible implications of the Examiner’s finding that Claim 26 has “inferential” language and language that is “so broad” it “encompasses everything.”

Not Broader than What Appellants Regard as their Invention

The Examiner does not assert that because of the purported breadth of Claim 26, or because of purported “inferential” language, the claim is not directed to what Appellants regard as their invention. There is no evidence of record that would remotely support any such finding

or grounds for rejection under § 112 (2), and the Examiner does not even indicate any. For instance, the Examiner has not indicated any statements by Appellants, beyond the patent specification, that may be relied upon in determining that Claim 26 does not correspond in scope with what Appellants regard as their invention. See, Solomon, 216 F.3d at 1377-1378; Conley, 490 F.2d at 976; see also, MPEP § 2172. In the absence of evidence to the contrary, the subject matter set out in a claim must be presumed to be that “which the applicant regards as his invention.” Moore, 439 F.2d at 1235.

Accordingly, there is no basis for finding that Claim 26 fails to recite what Appellants regard as their invention, and thus no grounds for rejection under § 112 (2).

Not Broader than the Disclosure

To the extent that the Examiner is holding that Claim 26 is broader than the disclosure because it “falls way short” of being limited to “a Blackjack type game” [Second Final Office Action, page 2], or has failed to recite essential matter that is only “inferred,” such rejections are more properly considered under the first paragraph of 35 U.S.C. § 112 than on the second paragraph. Robins, 429 F.2d at 456-57, n. 8 (citing In re Halleck, 422 F.2d 911 (C.C.P.A 1970); In re Borkowski, 422 F.2d 904 (C.C.P.A 1970); and In re Wakefield, 422 F.2d 897 (C.C.P.A 1970)); see also, MPEP § 2174 (“If a description or the enabling disclosure of a specification is not commensurate in scope with the subject matter encompassed by a claim, that fact alone does not render the claim imprecise or indefinite or other-wise not in compliance with 35 U.S.C. 112, second paragraph; rather, the claim is based on an insufficient disclosure (35 U.S.C. 112, first paragraph) and should be rejected on that ground.” (citing Borkowski)).

To the extent the Examiner intended a rejection under the first paragraph of § 112, the rejection must be reversed. The Specification contains at least one statement of Appellants’ invention that does not limit Claim 26 to “a Blackjack type game.” [See Specification, page 2, line 30 to page 3, line 13 (“...there is provided a method of administering a game, where the game involves at least a first random outcome and a second random outcome combined according to game rules to produce a game outcome.”)]. Further, the sufficiency of the

Specification to satisfy the “best mode” requirement of § 112 or to enable one skilled in the art to practice Appellants’ process as broadly as it is claimed has not been questioned by the Examiner.

Accordingly, the claims are not broader than the disclosure, and there are no grounds for a rejection under 35 U.S.C. § 112, first paragraph. See, Robins, 429 F.2d at 456.

1.5.11. Conclusion: The Claim of GROUP I Complies with § 112 (2)

In conclusion, the Examiner has not set forth a *prima facie* case of unpatentability of the claim of GROUP I under § 112 (2). In fact, Claim 26 (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently “definite”).

SEPARATE ARGUMENT OF PATENTABILITY

2. GROUP II

GROUP II includes independent Claim 27.

The rejection of the claim of GROUP II is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP II.

Specifically, the Examiner has not shown that any claim of GROUP II can be deemed to be either indefinite or anticipated by the prior art of record.

2.1. Independent Claim 27

Independent Claim 27 is directed to a method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner.

The method comprises allowing a player to select a specific score instead of a dealer's hand. A player's hand is dealt and played. The method also comprises comparing the player's hand to the specific score to determine a winner of the game.

2.2. Advantages of Independent Claim 27

The embodiment of Claim 27 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 27 is advantageous in that it provides for *allowing a player to select a specific score instead of a dealer's hand*. Thus, a player of a game may be allowed to select a specific score in lieu of having the dealer play a hand. According to one example, a player may request a score of "18" be used to replace a dealer's hand in a blackjack game. [Specification, page 3, lines 7-11]. By allowing a player to receive a specific score instead of a dealer's hand, a game played in accordance with such a provision may be more attractive to a player. For example, the player may have a greater sense of control over the

GROUP II

game and a feeling that the player can change his/her luck, or at least escape from a run of a certain kind of bad luck or from a continued term of bad luck. As a result, players may continue playing, rather than becoming discouraged. [Specification, page 5, lines 4-8].

In general, the method of Claim 27 is also advantageous in that it provides for *dealing and playing a player's hand*. Thus, the method allows for play of a game in which a hand of a player is dealt. In an example of a blackjack game, dealing and playing a player's hand would be a random outcome. [See, e.g., Specification, page 7, lines 17-18 (discussing dealing of a dealer's hand as a random outcome)]. Thus, dealing a player's hand and playing the player's hand is advantageous in that even if a player has selected a specific score instead of a dealer's hand, the effect of chance on the outcome of a game may not be excluded. [See, e.g., Specification, page 7, lines 11-13].

The winners of some types of games (e.g., blackjack) may be determined based on comparison of a player's hand with a score associated with a dealer (e.g., the "count value" of a dealer's hand). [See, e.g., Specification, page 1, lines 27-28]. The method of Claim 27 is further advantageous in that it provides for *comparing the player's hand and the specific score to determine a winner of a game*. Thus, *determining a winner* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18") *selected by a player in place of a dealer's hand* and (b) *the player's hand*. According to some embodiments, for example, the playing of the player's hand may result in a score (e.g., "20") that is compared with the specific score selected by the player replace the dealer's hand (e.g., "18"). For instance, in a game of blackjack, if the specific score "18" is less than the score which results from play of the dealer's hand, then the game rules may prescribe that the player wins (e.g., if the player's score is not greater than "21." Thus, Claim 27 advantageously allows that a player may be determined to be the winner of a game based on a comparison of *a specific score (selected instead of a dealer's hand) to the player's hand*.

2.3. No Prima Facie Showing of Anticipation of the Claim of GROUP II

A reading of the rejections of the claim of GROUP II reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP II.

The proper legal standards for anticipation are included in Section 1.3 above.

2.3.1. No showing that the references suggest allowing a player to select a specific score instead of a dealer's hand

Claim 27 recites a feature of *allowing a player to select a specific score instead of a dealer's hand* that is not disclosed by either Keller or Alvarez.

The dealer's hand is one of the "most important events" in the Keller system

As discussed in Section 1.3.1 above, Keller does not teach or suggest allowing a player to replace a random outcome with a specific score.

In fact, Keller describes "the Blackjack player's first two cards, and the Dealer's hand" as "the two most important events in a 21 game." [Column 9, lines 18-20 (emphasis added)].

Thus, Keller is devoid of any hint or suggestion of *allowing a player to select a specific score instead of a dealer's hand* (emphasis added).

Keller cannot suggest that a player may be allowed to *select a specific score instead of a dealer's hand*.

Nonetheless, the Examiner asserts: "As to Keller a player is allowed to select a specific entry, such as "4+5" or "21 bet" and this entry is compared to the dealers [sic] hand to determine a winner. Keller shows a 'side bet' game where these wagering options are evaluated 'instead of' the player's or dealer's hand." [Second Final Office Action, page 4].

The Examiner thus focuses inappropriately on an "evaluation" aspect of the Keller system without even asserting that Keller suggests *a selection by a player of a specific score instead of a dealer's hand* (emphasis added).

There is no suggestion that the “side bet” options in Keller of “4+5” and “21 bet” relied on by the Examiner are selected *instead of a dealer’s hand*, which is one of “the most important events of the game.”

The Examiner also asserts: “Keller shows a player selecting a ‘specific score[’] on the ‘players betting palette’ and comparing that to the dealers [sic] hand (for example dealer breaks) to determine the winner of the game.” [Second Final Office Action, page 3; First Final Office Action, page 3].

Appellants dispute that “dealer breaks” suggests *a specific score*.

Also, there is nothing in Keller that would suggest that the “dealer breaks” “side bet” is *selected by the player instead of a dealer’s hand*.

To the contrary, in recognizing that this “wagering option” in Keller is merely a “side bet,” the Examiner concedes that the dealer in the Keller system must still receive and play a dealer’s hand—the player is never *allowed to select a specific score instead of a dealer’s hand*.

The lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome

As discussed in Section 1.3.1 above, the lottery system of Alvarez does not teach *a specific score*. Accordingly, there is no suggestion of allowing a player to replace a random outcome, as is provided in Claim 27 by *allowing a player to select a specific score instead of a dealer’s hand* (emphasis added). The selected lottery numbers in Alvarez are not a specific entry or *a specific score*. They are not specified to replace or eliminate a random outcome. [Specification, page 7, lines 6-7, 11-13].

Nonetheless, the Examiner insists that the “specific score” is the “plurality of numbers” selected by the player. The Examiner simply asserts that this selection is “instead of a dealer’s hand.” [Second Final Office Action, page 5].

Appellants do not understand this assertion, and accordingly dispute this interpretation of Alvarez. The Examiner implies that a player has a choice of either selecting numbers to play or *a dealer’s hand*. The Examiner has never even attempted to cite a portion of Alvarez that

supports this strained interpretation—no such choice is remotely suggested. In fact, in discussing Claim 26, the Examiner states that the numbers randomly drawn in the lottery drawing suggest *a dealer's hand*. [Second Final Office Action, page 5]. Thus, the Examiner's assertion appears to be that a player can select a plurality of lottery numbers instead of having the lottery drawing take place at all—this does not make any sense. Applying the Examiner's interpretation of Alvarez, this interpretation would equate allowing a lottery customer to select the outcome of a lottery, which is clearly illogical.

Nothing in the lottery system of Alvarez even remotely suggests *a dealer's hand*, or a specific score, and therefore Alvarez cannot suggest allowing a player an option of *selecting a specific score instead of a dealer's hand*.

2.3.2. No showing that the references suggest comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game

Claim 27 provides for a feature of *comparing the player's hand to the specific score to determine a winner of the game* that is not disclosed by either Keller or Alvarez.

Keller does not teach a specific score selected instead of a dealer's hand

As discussed in Section 2.3.1 above, Keller cannot teach or suggest *allowing a player to select a specific score instead of a dealer's hand* (emphasis added). Accordingly, Keller cannot teach or suggest *comparing a specific score that is selected instead of a dealer's hand to a dealer's hand to determine a winner of a game*, as generally recited in independent Claim 27.

Alvarez does not teach a specific score selected instead of a dealer's hand

As discussed in Section 2.3.1 above, Alvarez cannot teach or suggest *a specific score or a dealer's hand*, much less *allowing a player to select a specific score instead of a dealer's hand* (emphasis added). Accordingly, Alvarez cannot teach or suggest *comparing a specific score (that is selected instead of a dealer's hand) to a player's hand to determine a winner of a game*, as generally recited in independent Claim 27.

The Examiner states that Alvarez shows comparing a specific score (allegedly the selected plurality of lottery numbers) to the player's hand (allegedly the "outcome of the lottery"). Appellants do not agree with this interpretation of Alvarez.

As best understood by Appellants, this characterization of a state-wide lottery drawing requires one to view the set of numbers drawn by the lottery authority (for use in comparison to all of the players' lottery picks) as *a player's hand* and strains credulity. It has no evidentiary basis in Alvarez or in what would have been known to one having ordinary skill in the art.

Further, with respect to Claim 26, the Examiner asserted that the lottery drawing suggested *a dealer's hand*, not *a player's hand*—there is no reconciling these mutually exclusive interpretations of the lottery drawing. [Second Final Office Action, page 5].

The conventional lottery drawing described in Alvarez does not suggest *dealing and playing a player's hand*, much less *comparing a player's hand to a specific score to determine a winner of the game*, as generally recited in independent Claim 27.

2.4. The Claim of GROUP II is Allowable Over the Cited References

As described in Section 2.3 above, the Examiner has failed to provide a *prima facie* showing of anticipation of the claim of GROUP II in light of either Keller or Alvarez.

In addition, as described above, neither of the references anticipates the claim of GROUP II.

In addition, the references cannot be combined in any manner that would render the claim of GROUP II obvious.

2.4.1. The references do not suggest all of the features

As discussed in Section 2.3 above, no cited reference suggests the features of:

- *allowing a player to select a specific score instead of a dealer's hand*
 - *comparing the player's hand to the specific score to determine a winner of the game*
- as recited in independent Claim 27.

Accordingly, the references, alone or in combination, cannot teach or suggest all of the features of the claim of GROUP II.

2.4.2. No motivation to combine the references

As discussed in Section 1.4.2 above, there is no suggestion in the record to make the combination or modification of the references, and the cited references are not analogous.

2.5. No Prima Facie Showing of Indefiniteness of the Claim of Group II

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP II, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP II does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP II as indefinite under § 112 (2).

Instead, contrary to law, the Examiner has expressly refused to consider the definiteness of disputed claim terms in light of the Specification.

Contrary to law, the Examiner expressly equates breadth of a claim with indefiniteness.

Contrary to law, the Examiner finds the use of language in the general format of *A depends on B* to be indefinite *per se*.

The Examiner has imposed several novel and extraneous definiteness requirements that have no legal basis:

- a claim must expressly explain a particular way that a process step might be practiced; otherwise the claim language is “inferential”
- a process claim must recite a structural relationship among recited terms

2.5.1. Whether or Not the Preamble is a Claim Limitation is Irrelevant to Overcoming the Examiner's § 112 (2) Rejection of the Claim of Group II

The preamble of Claim 27 is identical to the preamble of Claim 26. As discussed in Section 1.5.1 above, as the Examiner's findings with respect to the preamble are not sustainable, it is not necessary to determine whether the preamble does or does not actually include a claim limitation in order to reverse the § 112 (2) rejection.

2.5.2. The Proper Legal Standard under 35 U.S.C. § 112, Second Paragraph

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The proper legal standard for examination under § 112 (2) is discussed in Section 1.5.2 above.

2.5.3. Claim 27 Meets the Proper Legal Standard for Definiteness

27. (PREVIOUSLY PRESENTED) A method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner, comprising:

- allowing a player to select a specific score instead of a dealer's hand;
- dealing and playing a player's hand; and
- comparing the player's hand to the specific score to determine a winner of the game.

Claim 27 complies with both of the requirements of § 112, second paragraph: It (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently "definite").

With respect to the first requirement, Appellants affirmatively state that Claim 27 is consonant with one or more aspects their invention. There is no evidence of record that Claim 27 encompasses anything other than what Appellants regard as their invention. The Examiner has made no such assertion. Nonetheless, various comments by the Examiner (particularly with respect to the preamble and claim language that is allegedly “inferential”) compel Appellants to address the possibility that the Examiner believes that Claim 27 encompasses more than what Appellants regard as their invention. For convenience, the discussion in Section 1.5.10 above with respect to Claim 26 is sufficient to address these possibilities with respect to Claim 27.

With respect to the second requirement, the meaning of the language of Claim 27 meets the threshold requirement of being reasonably clear to one having ordinary skill in the art when considered in light of the Specification. The language is plain on its face. If this were not the case, which Appellants dispute, any lack of clarity is easily resolved by reference to the Specification, as required by the proper legal analysis.

The meaning of *a specific score* is discussed in Section 1.5.3 above. Some embodiments of the present invention provide for replacing the dealer’s hand in a game (e.g., a blackjack game) with a specific entry (e.g., a specific score)—*allowing a player to select a specific score instead of a dealer’s hand*. [Specification, page 3, lines 7-11]. In the types of embodiments to which Claim 27 is directed, then, *comparing* is between *the player’s hand and the specific score* (used to replace the dealer’s hand).

Appellants note that the terminology was definite enough for the Examiner to interpret the claims and find cause for a restriction of Claims 26 and 27. [First Non-Final Office Action mailed September 28, 2001]. The terminology was also definite enough for the Examiner to interpret the claims and find cause to reject Claim 27 as anticipated by asserted prior art in three subsequent Office Actions.

The disputed language, and the Examiner’s reasons for finding it indefinite, are discussed in detail herein. In summary, the Examiner has not provided any finding or legal basis that would support the rejection of Claim 27 under § 112 (2).

2.5.4. Appellants' Understanding of the Standards Applied by the Examiner to GROUP II

The claim of GROUP II is rejected by the Examiner under § 112 (2).

The Examiner applied all of the same novel standards in rejecting Claim 27 as in rejecting Claim 26. Briefly, the novel standards include the Examiner's Breadth is Indefiniteness Standard, the Examiner's *per se* Use of "Depends" Standard, and the Examiner's Inferential Standard, and the Examiner's Structural Relationship Standard.

Appellants' understanding of these standards used by the Examiner in rejecting the claim of GROUP II is discussed in Section 1.5.2 above.

The novel standards and analysis established by the Examiner have no legal basis.

The asserted failure of Claim 27 to comply with the Examiner's novel and baseless definiteness requirements form the grounds for the rejection of Claim 27 under § 112 (2). To the extent these standards depart from the requisite and proper legal analysis, they cannot support a rejection under § 112 (2).

2.5.5. The Examiner's Refusal to Consider the Specification in Determining Claim Definiteness is Contrary to Law

The indefiniteness rejection of the Claim of GROUP II is flawed and is contrary to law.

As discussed in Section 1.5.5 above, there is no evidence in the record that the Examiner has ever considered the definiteness of any language of any claim rejected under § 112 (2) in light of the Specification, as required by law. To the contrary, comments by the Examiner suggest that in analyzing the definiteness of the claims the Examiner has refused to consider any of the allegedly unclear language in light of the Specification. Please see Section 1.5.5 above for a discussion of the Examiner's basis for not considering the Specification in analyzing the claims for compliance under § 112 (2).

To the extent the Examiner did not consider the Specification, the Examiner's analysis of the definiteness of Claim 27 departs from the requisite and proper analysis under § 112 (2).

2.5.6. The Examiner's Breadth is Indefiniteness Standard Cannot Support a Rejection under § 112 (2)

As best understood by Appellants, the Examiner finds the preamble of Claim 27 is indefinite under the clearly erroneous Breadth is Indefiniteness Standard. [Second Final Action, pages 2, 4].

The preamble of Claim 26 is identical to that of Claim 27.

Accordingly, Appellants' reasons for why the language of the preamble is definite and why the Examiner's Breadth is Indefiniteness Standard cannot support a rejection under § 112 (2) are the same as those discussed in Section 1.5.6 above with respect to Claim 26.

In summary, the Examiner's Breadth is Indefiniteness Standard is clearly contrary to law. Breadth cannot be equated with indefiniteness, even if the claim breadth is "immense." See, Miller, 441 F.2d at 693; Robins, 429 F.2d at 458.

To the extent the Examiner relied upon the asserted breadth of the preamble of Claim 27 in rejecting that claim under § 112 (2), the rejection cannot stand.

2.5.7. The Examiner's *per se* Use of "Depends" Standard Cannot Support a Rejection under § 112 (2)

The Examiner finds that language in the preamble, *a game outcome that depends at least in part on a predetermined point total* (emphasis added), renders Claim 27 indefinite under the Examiner's *per se* Use of "Depends" Standard.

As discussed in Section 1.5.7 above, the mere use of "depends" is not a proper basis for rejecting Claim 27 under § 112 (2). To the extent the Examiner relied upon such a baseless *per se* rule, the rejection of Claim 27 cannot stand.

2.5.8. The Examiner's Inferential Standard Cannot Support a Rejection under § 112 (2)

As best understood by Appellants', every step of the claim of GROUP II includes language that purportedly fails the Examiner's Inferential Standard.

The language of Claim 27 is definite under § 112 (2).

The Examiner has not provided any evidence supporting a rejection under § 112 (2). To the contrary, the Examiner has identified each of the Alvarez and Keller references as teaching every feature of every claimed step. [Second Final Office Action, page 3 (rejecting Claim 27 as anticipated by each reference)]. Regardless of whether the Examiner's interpretations of the steps and / or the references are correct, the examples of the subject matter proffered by the Examiner clearly contradict the Examiner's allegation that one having ordinary skill in the art would have to "speculate" as to how to practice the claimed invention. This critically undermines any argument the language is unclear. Robins, 429 F.2d at 458.

As best understood by Appellants, the Examiner has many of the same objections to the same language in Claim 27 as in Claim 26. Namely, the Examiner believes that terms such as *allowing a player to select a specific score, a player's hand, comparing, and a dealer's hand* are "inferential." [Second Final Office Action, pages 2, 4]. The definiteness of this language is discussed above in Section 1.5.8 above.

With respect to the step of *comparing the player's hand to the specific score to determine a winner of the game*, the Examiner asserts that *a player's hand* is "inferential since how [it] can be compared is not set forth." [Second Final Office Action, page 2]. Appellants' best understanding is that under the Examiner's Inferential Standard, Appellants must explicitly recite at least one way one might practice the step of *comparing the specific score to the dealer's hand to determine a winner of the game*.

There is no requirement under § 112 (2) that Claim 27 must be "a self-contained explanation" of what *comparing the specific score to the dealer's hand* may entail. "That is not the role of claims." S3 Inc., 259 F.3d at 1369.

The Examiner in no way supports a finding that one having ordinary skill would be unable to determine what Appellants mean by *comparing the player's hand to the specific score*.

In addition, the Examiner also identified each of the Alvarez and Keller references as teaching the claimed step. [Second Final Office Action, page 3 (rejecting Claim 27 as

anticipated by each reference]). The enumeration of several examples critically undermines any argument the language is unclear to one having ordinary skill in the art. Robins, 429 F.2d at 458.

To the extent the Examiner relied upon the baseless Inferential Standard, the rejection of Claim 27 cannot stand.

Further, the recited steps of Claim 27 set out and circumscribes particular subject matter with a reasonable degree of precision and particularity. Accordingly, none of the disputed language of Claim 27 is proper grounds for a rejection under § 112 (2).

2.5.9. The Examiner's Structural Relationship Standard Cannot Support a Rejection under § 112 (2)

As discussed in Section 1.5.9 above, Appellants' best understanding is that under the Examiner's Structural Relationship Standard, Claim 27 is indefinite because the preamble does not specify a "physical" or "structural" relationship between *a game having a game outcome* and *a predetermined point total*.

As discussed in Section 1.5.9 above, Appellants' failure to recite a "structural relationship" or indicate "physical" dependence between a game and a point total is not a proper basis for rejecting Claim 27 under § 112 (2).

2.5.10. Claim 27 is Not Unduly Broad

The Examiner has made numerous assertions as to the breadth of language in the preamble of Claim 27. See discussion in Section 1.5.6 above. The Examiner has also asserted that language of Claim 27 is improperly unclear because some of it is "inferential."

Based on numerous references made to "indefiniteness" and "unclear" scope, Appellants presume that the Examiner rejected Claim 27 under § 112 (2) for lack of definiteness only. Nonetheless, Appellants feel compelled to address other possible implications of the Examiner's finding that Claim 27 has "inferential" language and language that is "so broad" it "encompasses everything." See discussion in Section 1.5.10 above.

The claims are not broader than the disclosure, and there are no grounds for a rejection under 35 U.S.C. § 112, first paragraph.

2.5.11. Conclusion: The Claim of GROUP II Complies with § 112 (2)

In conclusion, the Examiner has not set forth a *prima facie* case of unpatentability of the claim of GROUP II under § 112 (2). In fact, Claim 27 (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently "definite").

SEPARATE ARGUMENT OF PATENTABILITY

3. GROUP III

GROUP III includes independent Claim 38 and dependent Claim 39.

The rejection of the claims of GROUP III is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP III.

Specifically, the Examiner has not shown that any claim of GROUP III can be deemed to be indefinite or anticipated by the cited references.

3.1. Independent Claim 38

Independent Claim 38 is directed to a method. The method comprises receiving a wager for a game from a player, in which the game has a game outcome that depends at least in part on a predetermined count value and in which a rule of the game provides that the player may receive at least one card determined by chance.

The method further includes receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card.

A dealer score is determined based on a hand of the dealer, and an outcome of the game is determined based on the predetermined count value, the specific entry, and the dealer score.

3.2. Advantages of Independent Claim 38

The embodiment of Claim 38 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 38 is advantageous in that it provides for play of a game *in which a rule of the game provides that a player may receive at least one card determined by chance*. Thus, in accordance with the rule, the game allows that a player could receive at least one random card. For example, a game of blackjack typically allows (and may

require) a player to receive a hand of cards (e.g., conventionally used to compare against a hand of cards dealt to a dealer).

The method of Claim 38 is further advantageous in that it provides for *receiving a request from a player for a specific entry, in which the specific entry is in place of the at least one card*. Thus, a player of a game may be allowed to select a specific entry (e.g., a specific score such as "18") in lieu of receiving the at least one card by chance, as afforded by the recited *rule*. According to one example, a player may request a score of "18" be used to replace a player's hand in a blackjack game. [Specification, page 3, lines 7-11; page 7, lines 9-16]. Thus, even though a rule of the game allows for the random event of a player hand, for example, the player may eliminate that random outcome. By allowing a player to receive a specific score instead of a player's hand, a game played in accordance with such a provision may be more attractive to a player. For example, the player may have a greater sense of control over the game and a feeling that the player can change his/her luck, or at least escape from a run of a certain kind of bad luck or from a continued term of bad luck. As a result, players may continue playing, rather than becoming discouraged. [Specification, page 5, lines 4-8].

In general, the method of Claim 38 is also advantageous in that it provides for *determining a dealer score based on a hand of a dealer*. Thus, the method allows for play of a game in which a dealer has a hand. In an example of a blackjack game, dealing and playing a dealer's hand would be a random outcome. [See, e.g., Specification, page 7, lines 17-18]. Determining a dealer score based on the dealer's hand is advantageous in that even if a player has selected a specific score instead of a player's hand, the effect of chance on the outcome of a game may not be excluded. [See, e.g., Specification, page 7, lines 11-13].

The winners of some types of games (e.g., blackjack) may be determined based on comparison with a predetermined count value (e.g., "a twenty-one count" which if exceeded results in a "bust"). [See, e.g., Specification, page 1, lines 27-28]. The method of Claim 38 is further advantageous in that it provides for determining an outcome of the game based on (a) *a predetermined count value*, (b) *the specific entry*, and (c) *the dealer score*. According to some embodiments, for example, the playing of a dealer's hand may result in a score that is

compared with the specific entry selected by the player to determine a winner. For instance, in a game of blackjack, if the specific entry is higher than the dealer score, and is not greater than the predetermined count value (e.g., "21"), then the game rules may prescribe that the player wins. However, if the score obtained from the dealer's hand is higher than the specific entry, then the dealer wins. [See, e.g., Specification, page 20-24]. Thus, Claim 38 advantageously allows that an outcome of a game may be determined based on *a specific entry (that is selected in place of a player's hand), a predetermined point value, and a dealer score.*

3.3. No Prima Facie Showing of Anticipation of the Claim of GROUP III

A reading of the rejections of the claim of GROUP III reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP III.

The proper legal standards for anticipation are included in Section 1.3 above.

3.3.1. No showing that the references suggest receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card

Claim 38 recites a feature of *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card*, that is not disclosed by either Keller or Alvarez. As generally recited in Claim 38, in accordance with *a rule of the game, the at least one card is determined by chance and may be received by the player.*

Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation of the claim of GROUP III.

According to one aspect of the present invention applied as a modification of blackjack, a player can request a specific entry (e.g., a specific score) to replace either the player's hand or the dealer's hand. For example, the player may request a score of eighteen to be compared against the dealer's hand, or may request that the dealer's hand be replaced with a score of

eighteen and that the player's hand be compared against that score in determining a winner of the game. [See, e.g., Specification, page 3, lines 7-15].

Keller requires a player's hand

For the reasons stated in Section 1.3.1 above, Appellants submit that Keller does not teach or suggest allowing a player to replace a random outcome with a specific score, much less providing for *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card that is determined by chance* (emphasis added).

In fact, Keller describes “the Blackjack player's first two cards, and the Dealer's hand” as “the two most important events in a 21 game.” [Column 9, lines 18-20 (emphasis added)].

Keller even **requires** that two cards be dealt to a player. The entirety of the Keller disclosure is focused “on the first two initial cards since in many cases there are no more cards dealt to the Blackjack player, than the required minimum of the two initial cards dealt by a Dealer to the Blackjack player.” [Column 6, lines 46-50 (emphasis added)]. According to Keller, a blackjack player “expects to” be dealt an initial hand of two cards. [Column 10, lines 17-20].

The lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome

For the reasons stated in Section 1.3.1 above, Appellants submit that the lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome with a specific score, much less providing for *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card* (emphasis added).

3.3.2. No showing that the references suggest determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score

Claim 38 provides for a feature of *determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score* that is not disclosed by either Keller or Alvarez.

According to one blackjack example, “[i]f the score provided by the specific entry is higher than the score which results from the dealer’s hand (random outcome) then the game rules prescribe that the player wins.” [Specification, page 7, lines 22-24]. For instance, an outcome of the game (e.g., the winner) is determined based on the non-random, *specific entry* (e.g., “18”) *that is requested by a player in place of at least one card, a dealer score* (e.g., “19”) and a *predetermined count value* (e.g., “21”).

Keller does not teach a specific entry, in which the specific entry is in place of the at least one card

As discussed in Section 3.3.1 above, Keller cannot teach or suggest *a specific entry, in which the specific entry is in place of the at least one card* (emphasis added). Keller requires a player hand. Accordingly, Keller cannot teach or suggest *determining an outcome of a game based on such a specific entry*, as generally recited in independent Claim 26.

Alvarez does not teach a specific entry requested in place of a player’s hand

As discussed in Section 3.3.1 above, Alvarez cannot teach or suggest *a specific entry, in which the specific entry is in place of the at least one card* (emphasis added). Accordingly, Alvarez cannot teach or suggest *determining an outcome of a game based on such a specific entry*, as generally recited in independent Claim 26.

The Examiner asserts: “the outcome of the game in Alvarez is based on the numbers selected by the player as being his specific entry of a predetermined count value usually ranging from numbers 1-40 and the dealer’s score selected by the lottery.” [Second Final Office Action, page 5].

For the reasons stated in Section 1.3.2 above, Appellants do not agree with this interpretation of Alvarez. Contrary to the Examiner's assertions, the pool of numbers from which a player may select a lottery number (e.g., 1-40) in the Alvarez lottery system cannot teach or suggest *a predetermined count value*, much less *determining an outcome of a game based on a dealer score, a specific entry, and a predetermined count value*.

3.4. The Claim of GROUP III is Allowable Over the Cited References

As described above, the Examiner has failed to provide a *prima facie* showing of anticipation of the claim of GROUP III in light of either Keller or Alvarez.

In addition, as described above, neither of the references anticipates the claim of GROUP III.

In addition, the references cannot be combined in any manner that would render the claim of GROUP III obvious.

3.4.1. The references do not suggest all of the features

As discussed in Section 1.3 above, no cited reference suggests the features of:

- *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card*
- *determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score*

as recited in independent Claim 38.

Accordingly, the references, alone or in combination, cannot teach or suggest all of the features of the claim of GROUP III.

3.4.2. No motivation to combine the references

As discussed in Section 1.4.2 above, there is no suggestion in the record to make the combination or modification of the references, and the cited references are not analogous.

3.5. No Prima Facie Showing of Indefiniteness of the Claim of Group III

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP III, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP III does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP III as indefinite under § 112 (2).

Instead, contrary to law, the Examiner has expressly refused to consider the definiteness of disputed claim terms in light of the Specification.

Contrary to law, the Examiner expressly equates breadth of a claim with indefiniteness.

Contrary to law, the Examiner finds the use of language in the general format of *A depends on B* to be indefinite *per se*.

The Examiner has imposed several novel and extraneous definiteness requirements that have no legal basis:

- a claim must expressly explain a particular way that a process step might be practiced; otherwise the claim language is "inferential"

3.5.1. The Proper Legal Standard under 35 U.S.C. § 112, Second Paragraph

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The proper legal standard for examination under § 112 (2) is discussed in Section 1.5.2 above.

3.5.2. Claim 38 Meets the Proper Legal Standard for Definiteness

38. (PREVIOUSLY PRESENTED) A method comprising:
- receiving a wager for a game from a player,
 - in which the game has a game outcome that depends at least in part on a predetermined count value, and
 - in which a rule of the game provides that the player may receive at least one card determined by chance;
 - receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card;
 - determining a dealer score based on a hand of a dealer; and
 - determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score.

Claim 38 complies with both of the requirements of § 112, second paragraph: It (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently “definite”).

With respect to the first requirement, Appellants affirmatively state that Claim 38 is consonant with one or more aspects their invention. There is no evidence of record that Claim 38 encompasses anything other than what Appellants regard as their invention. The Examiner has made no such assertion. Nonetheless, various comments by the Examiner (particularly with respect to the preamble and claim language that is allegedly “inferential”) compel Appellants to address the possibility that the Examiner believes that Claim 38 encompasses more than what Appellants regard as their invention. For convenience, the discussion in

Section 1.5.10 above with respect to Claim 26 is sufficient to address these possibilities with respect to Claim 38.

With respect to the second requirement, the meaning of the language of Claim 38 meets the threshold requirement of being reasonably clear to one having ordinary skill in the art when considered in light of the Specification. The language is plain on its face. If this were not the case, which Appellants dispute, any lack of clarity is easily resolved by reference to the Specification, as required by the proper legal analysis.

The meaning of *a specific entry* is discussed in Section 1.5.3 above. Some embodiments of the present invention provide for replacing *at least one card determined by chance that may be received by the player according to a rule of the game* (e.g., a player's hand) in a game (e.g., a blackjack game) with *a specific entry* (e.g., a specific score of "18"), and *receiving a request for a specific entry in place of at least one card determined by chance*. [Specification, page 7, lines 9-15]. In Claim 38, *determining an outcome of the game* (e.g., whether the player has won or lost) *is based on the dealer score, the specific entry* (used to replace the player's hand), and *a predetermined count value* (e.g., "21" in a game of blackjack). [See, e.g., Specification, page 7, lines 19-27]. The *predetermined count value* may be used, for example, to determine if the player "busts." [See, e.g., Specification, page 1, lines 26-29].

Appellants note that the terminology of Claim 38 was definite enough for the Examiner to interpret the claims and find cause to reject Claim 38 as anticipated by asserted prior art in three subsequent Office Actions.

With regard to claim 38, however, the Examiner states that claim 38 is unclear because "a 'count value' of what is not stated." Applicants respectfully submit that count values are described in Applicants' specification. [See, e.g., Specification, page 4, lines 17-20]. Accordingly the use of "count value" is not unclear. As discussed in Section 3.5.4 below, however, the Examiner has refused to consider the Specification.

The Examiner further states "that a player 'may receive' a card by chance is indefinite in the sense that this defines every card game." However, whether or not Applicants' claim

language defines every card game has nothing to do with making the claim language indefinite. Breadth is not to be equated with indefiniteness. See discussion in Section 3.5.5 below.

The Examiner also states that in line 6 of claim 38, "the player" lacks antecedent basis. However, line 2 of Claim 38 sets forth "a player". In response to this, the Examiner confusingly states that "the player" in line 2 is only a "functional recitation." [Second Final Office Action, page 5]. Appellants do not understand this finding, and it cannot support an indefiniteness rejection under § 112 (2). The wager is clearly received *from a player*; as clearly indicated, the rule of the game allows that *that player* could receive at least one card determined by chance.

The Examiner has also stated that a hand of the dealer "is inferential since steps of cards [sic] and dealing 'hands' is not recited". However, that something in a method claim is 'inferential' would not render a claim indefinite. In addition, a claim need not provide a written description of the invention.

The Examiner also states that in claim 38 the predetermined count value "lacks a proper antecedent since it has only been previously functionally recited." Applicants respectfully submit that whether or not "predetermined count value" was recited functionally is irrelevant to definiteness. See discussion in Section 3.5.6 below.

In summary, the Examiner has not provided any finding or legal basis that would support the rejection of Claim 38 under § 112 (2).

3.5.3. Appellants' Understanding of the Standards Applied by the Examiner to GROUP III

The claim of GROUP III is rejected by the Examiner under § 112 (2).

The Examiner applied several of the same novel standards in rejecting Claim 38 as in rejecting Claim 26. Briefly, the novel standards include the Examiner's Breadth is Indefiniteness Standard and the Examiner's Inferential Standard.

Appellants' understanding of these standards used by the Examiner in rejecting the claim of GROUP III is discussed in Section 1.5.2 above.

The novel standards and analysis established by the Examiner have no legal basis.

The asserted failure of Claim 38 to comply with the Examiner's novel and baseless definiteness requirements form the grounds for the rejection of Claim 38 under § 112 (2). To the extent these standards depart from the requisite and proper legal analysis, they cannot support a rejection under § 112 (2).

3.5.4. The Examiner's Refusal to Consider the Specification in Determining Claim Definiteness is Contrary to Law

The indefiniteness rejection of the Claim of GROUP III is flawed and is contrary to law.

As discussed in Section 1.5.5 above, there is no evidence in the record that the Examiner has ever considered the definiteness of any language of any claim rejected under § 112 (2) in light of the Specification, as required by law.

In fact, with respect to Claim 38, the Examiner asserts: "the recitation of 'a count value' in the specification does not render it clear since such limitation [sic] is not read into the claims. See *In re Prater* above." [Second Final Office Action, page 4].

As discussed in Section 1.5.5 above, the Examiner must consider the Specification. A failure to do so is not excused by any holding of *In re Prater*, which the Examiner has misread and misapplied.

To the extent the Examiner did not consider the Specification, the Examiner's analysis of the definiteness of Claim 38 departs from the requisite and proper analysis under § 112 (2).

3.5.5. The Examiner's Breadth is Indefiniteness Standard Cannot Support a Rejection under § 112 (2)

Accordingly, Appellants' reasons for why the Examiner's Breadth is Indefiniteness Standard is contrary to law and cannot support a rejection under § 112 (2) are the same as those discussed in Section 1.5.6 above with respect to Claim 26.

As best understood by Appellants, the Examiner finds language of Claim 38 to be "set forth so broadly that one cannot determine what it is intended to cover, the claim is considered indefinite...." [Second Final Office Action, pages 4-5 (citing *Ex parte Wu*)].

The Examiner refers specifically to *in which a rule of the game provides that the player may receive at least one card determined by chance* (emphasis added). There is nothing indefinite about *may receive*. It accurately and distinctly describes a rule of the game: a player may receive at least one card determined by chance. It is not intended to specify that a player does or does not receive a card. Various examples in the Specification refer to blackjack and to draw poker. One having ordinary skill in the art would readily appreciate that in such games a player typically may receive at least once card determined by chance.

The Examiner, however, merely concludes that recited rule is indefinite “in the sense that this defines every card game” (emphasis added). [Second Final Office Action, page 2]. Again, the Examiner has found “indefinite” what he clearly believes is definite, and merely broad. The Examiner concedes that the disputed language in fact defines subject matter (even if it “defines every card game”). Breadth cannot be equated with indefiniteness, even if the claim breadth is “immense.” See, Miller, 441 F.2d at 693; Robins, 429 F.2d at 458.

Ex parte Wu does not support any equating of breadth with indefiniteness. The Examiner has misread any holding of that opinion.

To the extent the Examiner relied upon the asserted breadth of the preamble of Claim 38 in rejecting that claim under § 112 (2), the rejection cannot stand.

3.5.6. The Examiner’s Inferential Standard Cannot Support a Rejection under § 112 (2)

As best understood by Appellants’, every step of the claim of GROUP III includes language that purportedly fails the Examiner’s Inferential Standard.

The language of Claim 38 is definite under § 112 (2).

In addition, the Examiner also identified each of the Alvarez and Keller references as teaching the claimed step. [Second Final Office Action, page 3 (rejecting Claim 38 as anticipated by each reference)]. The enumeration of several examples critically undermines any argument the language is unclear to one having ordinary skill in the art. Robins, 429 F.2d at 458.

The step of *determining a dealer score based on a hand of a dealer* is clear. The Examiner objects that “steps of cards and dealing ‘hands’ is not recited.” [Second Final Office Action, page 2]. As discussed in Section 1.5.8 above, there is no such requirement for definiteness under § 112 (2) that Claim 38 must be “a self-contained explanation” of what *determining a dealer score based on a hand of a dealer* may entail. “That is not the role of claims.” S3 Inc., 259 F.3d at 1369.

The Examiner in no way supports a finding that one having ordinary skill would be unable to determine what Appellants mean by *determining a dealer score based on a hand of a dealer*.

To the extent the Examiner relied upon the baseless Inferential Standard, the rejection of Claim 38 cannot stand.

The recited steps of Claim 38 set out and circumscribe particular subject matter with a reasonable degree of precision and particularity. Accordingly, none of the disputed language of Claim 38 is proper grounds for a rejection under § 112 (2).

3.5.7. Claim 38 is Not Unduly Broad

The Examiner has made numerous assertions as to the breadth of language in the preamble of Claim 38. See discussion in Section 1.5.6 above. The Examiner has also asserted that language of Claim 38 is improperly unclear because some of it is “inferential.”

Based on numerous references made to “indefiniteness” and “unclear” scope, Appellants presume that the Examiner rejected Claim 38 under § 112 (2) for lack of definiteness only. Nonetheless, Appellants feel compelled to address other possible implications of the Examiner’s finding that Claim 38 has “inferential” language and language that is “so broad” it “encompasses everything.” See discussion in Section 1.5.10 above.

The claims are not broader than the disclosure, and there are no grounds for a rejection under 35 U.S.C. § 112, first paragraph.

3.5.8. Conclusion: The Claim of GROUP III Complies with § 112 (2)

In conclusion, the Examiner has not set forth a *prima facie* case of unpatentability of the claim of GROUP III under § 112 (2). In fact, Claim 38 (i) sets forth subject matter that Appellants regard as their invention; and (ii) does so with sufficient particularity and distinctness (i.e., it is sufficiently "definite").

SEPARATE ARGUMENT OF PATENTABILITY

4. GROUP IV

GROUP IV includes independent Claim 40 and dependent Claim 41.

The rejection of the claims of GROUP IV is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP IV.

Specifically, the Examiner has not shown that any claim of GROUP IV can be deemed to be indefinite or anticipated by the cited references.

4.1. Independent Claim 40

Independent Claim 40 is directed to a method. The method comprises receiving a wager for a game from a player, in which the game has a game outcome that depends at least in part on a predetermined count value and in which a rule of the game provides that a dealer may receive at least one card determined by chance.

The method further includes receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card.

A player score is determined based on a hand of the player, and an outcome of the game is determined based on the predetermined count value, the specific entry, and the player score.

4.2. Advantages of Independent Claim 40

The embodiment of Claim 40 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 40 is advantageous in that it provides for play of a game *in which a rule of the game provides that a dealer may receive at least one card determined by chance*. Thus, in accordance with the rule, the game allows that a dealer could receive at least one random card. For example, a game of blackjack typically allows (and may

require) a dealer to receive a hand of cards (e.g., conventionally used to compare against a hand of cards dealt to a player).

The method of Claim 40 is further advantageous in that it provides for *receiving a request from a player for a specific entry, in which the specific entry is in place of the at least one card*. Thus, a player of a game may be allowed to select a specific entry (e.g., a specific score such as "18") in lieu of having the dealer receive the at least one card by chance, as afforded by the recited *rule*. According to one example, a player may request a score of "18" be used to replace a dealer's hand in a blackjack game. [Specification, page 3, lines 7-11; page 7, lines 9-16]. Thus, even though a rule of the game allows for the random event of a dealer's hand, for example, the player may eliminate that random outcome. By allowing a player to select a specific entry instead of a dealer's hand, a game played in accordance with such a provision may be more attractive to a player. For example, the player may have a greater sense of control over the game and a feeling that the player can change his/her luck, or at least escape from a run of a certain kind of bad luck or from a continued term of bad luck. As a result, players may continue playing, rather than becoming discouraged. [Specification, page 5, lines 4-8].

In general, the method of Claim 40 is also advantageous in that it provides for *determining a player score based on a hand of a player*. Thus, the method allows for play of a game in which a player has a hand. Determining a player score based on a player's hand is advantageous in that even if a player has selected a specific entry in place of a dealer's hand, the effect of chance on the outcome of the game may not be excluded. [See, e.g., Specification, page 7, lines 11-13].

The winners of some types of games (e.g., blackjack) may be determined based on comparison with a predetermined count value (e.g., "a twenty-one count" which if exceeded results in a "bust"). [See, e.g., Specification, page 1, lines 27-28]. The method of Claim 40 is further advantageous in that it provides for determining an outcome of the game based on (a) *a predetermined count value*, (b) *the specific entry*, and (c) *the player score*. According to some embodiments, for example, the playing of a player's hand may result in a score that is

compared with the specific entry selected by the player (e.g., in place of a dealer's hand) to determine a winner. For instance, in a game of blackjack, if the specific entry is higher than the player score, and is not greater than the predetermined count value (e.g., "21"), then the game rules may prescribe that the dealer wins. Thus, Claim 40 advantageously allows that an outcome of a game may be determined based on *a specific entry (that is selected in place of a dealer's hand), a predetermined point value, and a dealer score.*

4.3. No Prima Facie Showing of Anticipation of the Claim of GROUP IV

A reading of the rejections of the claim of GROUP IV reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP IV.

The proper legal standards for anticipation are included in Section 1.3 above.

4.3.1. No showing that the references suggest receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card

Claim 38 recites a feature of *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card*, that is not disclosed by either Keller or Alvarez. As generally recited in Claim 40, in accordance with *a rule of the game, the at least one card is determined by chance and may be received by the dealer.*

Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation of the claim of GROUP IV.

The dealer's hand is one of the "most important events" in the Keller system

As discussed in Section 1.3.1 above, Keller does not teach or suggest allowing a player to replace a random outcome with a specific score.

In fact, Keller describes “the Blackjack player’s first two cards, and the Dealer’s hand” as “the two most important events in a 21 game.” [Column 9, lines 18-20 (emphasis added)].

Also, for the reasons stated in Section 2.3.1 above, Appellants submit that Keller does not teach or suggest allowing a player to replace a random outcome with a specific score, much less providing for *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card that is determined by chance* (emphasis added).

The lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome

For the reasons stated in Section 2.3.1 above, Appellants submit that the lottery system of Alvarez does not teach or suggest allowing a player to replace a random outcome with a specific score, much less providing for *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card that may be received by a dealer* (emphasis added).

4.3.2. No showing that the references suggest determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score

Claim 38 provides for a feature of *determining an outcome of the game based on the predetermined count value, the specific entry, and the player score* that is not disclosed by either Keller or Alvarez.

Keller does not teach a specific entry, in which the specific entry is in place of the at least one card

As discussed in Section 4.3.1 above, Keller cannot teach or suggest *a specific entry, in which the specific entry is in place of the at least one card determined by chance that may be received by a dealer* (emphasis added). Accordingly, Keller cannot teach or suggest *determining an outcome of a game based on such a specific entry*, as generally recited in independent Claim 26.

Alvarez does not teach a specific entry requested in place of a player's hand

As discussed in Section 4.3.1 above, Alvarez cannot teach or suggest *a specific entry, in which the specific entry is in place of the at least one card that may be received by a dealer* (emphasis added). Accordingly, Alvarez cannot teach or suggest *determining an outcome of a game based on such a specific entry*, as generally recited in independent Claim 26.

The Examiner states that Alvarez shows comparing a specific score (allegedly the selected plurality of lottery numbers) to the player's hand (allegedly the "outcome of the lottery"). [Second Final Office Action, page 4]. Appellants do not agree with this interpretation of Alvarez.

As best understood by Appellants, this characterization of a state-wide lottery drawing requires one to view the set of numbers drawn by the lottery authority (for use in comparison to all of the players' lottery picks) as *a player's hand*, much less *a player score*, and strains credulity. It has no evidentiary basis in Alvarez or in what would have been known to one having ordinary skill in the art.

Further, with respect to Claim 26, the Examiner asserted that the lottery drawing suggested *a dealer's hand*, not *a player's hand*—there is no reconciling these mutually exclusive interpretations of the lottery drawing. [Second Final Office Action, page 5].

The conventional lottery drawing described in Alvarez does not suggest *determining a player score based on a hand of a player*, much less *determining an outcome of the game based on the predetermined count value, the specific entry, and the player score*, as generally recited in independent Claim 40.

4.4. The Claim of GROUP IV is Allowable Over the Cited References

As described above, the Examiner has failed to provide a *prima facie* showing of anticipation of the claim of GROUP IV in light of either Keller or Alvarez.

In addition, as described above, neither of the references anticipates the claim of GROUP IV.

In addition, the references cannot be combined in any manner that would render the claim of GROUP IV obvious.

4.4.1. The references do not suggest all of the features

As discussed in Section 1.3 above, no cited reference suggests the features of:

- *receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card*
- *determining an outcome of the game based on the predetermined count value, the specific entry, and the player score*

as recited in independent Claim 40.

Accordingly, the references, alone or in combination, cannot teach or suggest all of the features of the claim of GROUP IV.

4.4.2. No motivation to combine the references

As discussed in Section 1.4.2 above, there is no suggestion in the record to make the combination or modification of the references, and the cited references are not analogous.

4.5. No Prima Facie Showing of Indefiniteness of the Claim of Group IV

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP IV, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP IV does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP IV as indefinite under § 112 (2).

The Examiner asserts that Claim 40 is rejected under § 112 (2) on the same basis as Claim 38.

Accordingly, Appellants dispute the Examiner's § 112 (2) rejection of Claim 40 for the same reasons as discussed with respect to Claim 38 in Section 3.5 above.

SEPARATE ARGUMENT OF PATENTABILITY

5. GROUP V

GROUP V includes independent Claim 42 and dependent Claims 43-45 and 47-51.

The rejection of the claims of GROUP V is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP V.

Specifically, the Examiner has not shown that any claim of GROUP V can be deemed to be indefinite or anticipated by the cited references.

5.1. Independent Claim 42

Independent Claim 42 is directed to a method. The method comprises receiving a request from the player, the request indicating a specific score to be used in place of a hand of the player. The method further includes determining a hand of a dealer, and comparing the specific score and the hand of the dealer to determine a winner of a game of twenty-one.

5.2. Advantages of Independent Claim 42

The embodiment of Claim 42 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 42 is advantageous for the same reasons as independent Claim 38, discussed in Section 3.2 above. In Claim 42, the player may request for *a specific score to be used in place of a hand of the player*. The advantages of this type of *a specific score* are discussed with respect to Claim 26 in Section 1.2 above.

The winners of some types of games (e.g., twenty-one) may be determined conventionally based on comparison of a hand of a player and a hand of a dealer. The method of Claim 42 is further advantageous in that it provides for *comparing the specific score to the hand of the dealer to determine a winner of a game*. Thus, *determining a winner* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18")

GROUP V

selected by a player in place of a player's hand, and (b) the dealer's hand. According to some embodiments, for example, a dealer's hand may be associated with a score that is compared with the specific score selected by the player to determine a winner. For instance, if the specific score is higher than the score which results from play of the dealer's hand then the game rules may prescribe that the player wins. However, if the score obtained from the dealer's hand is higher than the specific score, then the dealer wins. [See, e.g., Specification, page 20-24]. Thus, Claim 42 advantageously allows that a player may be determined to be the winner of a game based on a comparison of *a specific score (selected instead of a player's hand) to a dealer's hand.*

5.3. No Prima Facie Showing of Anticipation of the Claim of GROUP V

A reading of the rejections of the claim of GROUP V reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP V.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 42 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a prima facie case of anticipation with respect to Claim 42 for at least the reasons provided with respect to Keller in Section 1.3 above (discussing Claim 26). Namely, Keller does not teach or suggest allowing a player to eliminate at least one random outcome, and in fact **requires** a player to have a hand, which in the Keller system is one of the "most important events." Thus, Keller is devoid of any hint or suggestion of allowing *a player to request a specific score for use in place of a hand of a player* (emphasis added).

5.4. No Prima Facie Showing of Indefiniteness of the Claim of Group V

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP V, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP V does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP V as indefinite under § 112 (2).

Regarding claim 42, the Examiner states that "'a hand of a dealer' is inferential since no hands or dealers are cited." [Second Final Office Action, page 2]. As discussed in Section 1.5.8 above, however, the Examiner's Inferential Standard has no basis in law. The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having ordinary skill in the art would readily appreciate how a hand of a dealer may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

Regarding the Examiner's comment regarding use of "twenty-one", the breadth of a claim is not to be equated with indefiniteness. See Moore. The Examiner's Breadth is Indefiniteness Standard has no basis in law, as discussed in Section 1.5.6 above. That many variations may be known fatally undercuts the Examiner's argument that the scope of the term is not clear. See Robins.

The Examiner's objection to "associated with the player" has been previously addressed—this language has been replaced.

To the extent the Examiner intended to reject Claim 42 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

GROUP V

No finding has been made that Claim 42 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

6. GROUP VI

GROUP VI includes independent Claim 56 and dependent Claims 57-63 and 67-69.

The rejection of the claims of GROUP VI is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP VI.

Specifically, the Examiner has not shown that any claim of GROUP VI can be deemed to be indefinite or anticipated by the cited references.

6.1. Independent Claim 56

Independent Claim 56 is directed to a method. The method comprises receiving a request from a player, the request indicating a specific score to be used in place of a hand of the dealer. The method further includes determining a hand of a player, and comparing the specific score and the hand of the player to determine a winner of a game of twenty-one.

6.2. Advantages of Independent Claim 56

The embodiment of Claim 56 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 56 is advantageous for the same reasons as independent Claim 40, discussed in Section 4.2 above. In Claim 56, the player may request for *a specific score to be used in place of a hand of the player*. The advantages of this type of *a specific score* are discussed with respect to Claim 26 in Section 2.2 above.

The winners of some types of games (e.g., twenty-one) may be determined conventionally based on comparison of a hand of a player and a hand of a dealer. The method of Claim 56 is further advantageous in that it provides for *comparing a specific score to the hand of the player to determine a winner of a game*. Thus, *determining a winner* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18")

selected by a player in place of a dealer's hand, and (b) the player's hand. According to some embodiments, for example, a player's hand may be associated with a score that is compared with the specific score selected by the player (in place of a dealer's hand) to determine a winner. Thus, Claim 56 advantageously allows that a player may be determined to be the winner of a game based on a comparison of *a specific score (selected instead of a dealer's hand) to a player's hand.*

6.3. No Prima Facie Showing of Anticipation of the Claim of GROUP VI

A reading of the rejections of the claim of GROUP VI reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP VI.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 56 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a prima facie case of anticipation with respect to Claim 56 for at least the reasons provided with respect to Keller in Section 2.3 above (discussing Claim 27). Namely, Keller does not teach or suggest eliminating at least one random outcome of a game, and a dealer's hand is one of "the most important events" in play of the Keller system. Thus, Keller is devoid of any hint or suggestion of allowing a *player to request a specific score for use in place of a hand of a dealer* (emphasis added).

6.4. No Prima Facie Showing of Indefiniteness of the Claim of Group VI

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP VI, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP VI does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP VI as indefinite under § 112 (2).

Regarding claim 56, the Examiner states that determining a hand of a player is “inferential since one must infer that a hand exists and what it comprises. [Second Final Office Action, page 3]. As discussed in Section 1.5.8 above, however, the Examiner’s Inferential Standard has no basis in law. The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having ordinary skill in the art would readily appreciate how a hand of a player may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

Regarding the Examiner’s comments regarding use of “twenty-one”, the breadth of a claim is not to be equated with indefiniteness. See Moore. The Examiner’s Breadth is Indefiniteness Standard has no basis in law, as discussed in Section 1.5.6 above. That many variations may be known fatally undercuts the Examiner’s argument that the scope of the term is not clear. See Robins.

The Examiner’s objection to “associated with the player” has been previously addressed—this language has been replaced.

To the extent the Examiner intended to reject Claim 56 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 56 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

7. GROUP VII

GROUP VII includes independent Claim 70 and dependent Claim 71.

The rejection of the claims of GROUP VII is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP VII.

Specifically, the Examiner has not shown that any claim of GROUP VII can be deemed to be indefinite or anticipated by the cited references.

7.1. Independent Claim 70

Independent Claim 70 is directed to a method. The method comprises allowing a player of a game of blackjack to select one of: (i) receiving a hand comprising at least one card, and (ii) requesting a specific entry.

The method further includes receiving a request from the player, the request indicating a specific score. A dealer score is determined based on a hand of a dealer, and an outcome of the game is determined based on the specific score and the dealer score.

7.2. Advantages of Independent Claim 70

The embodiment of Claim 70 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 70 is advantageous for the same reasons as independent Claim 42, discussed in Section 5.2 above.

In Claim 70, the player is expressly allowed to select either receiving a hand or requesting a specific entry. Claim 70 is further advantageous in *receiving a request from a player that indicates a specific score*. The advantages of this type of *a specific score* are discussed with respect to Claim 26 in Section 1.2 above.

The winners of some types of games (e.g., blackjack) may be determined conventionally based on comparison of a hand of a player and a hand of a dealer. The method of Claim 70 is further advantageous in that it provides for *determining an outcome of the game based on the specific score and a dealer score*. Thus, *determining an outcome* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18") *selected by a player instead of selecting a hand*, and (b) *the dealer score*. According to some embodiments, for example, a dealer's hand may be associated with a score that is compared with the specific score selected by the player to determine a winner. For instance, if the specific score is higher than the score which results from play of the dealer's hand then the game rules may prescribe that the player wins. However, if the score obtained from the dealer's hand is higher than the specific score, then the dealer wins. [See, e.g., Specification, page 20-24].

7.3. No Prima Facie Showing of Anticipation of the Claim of GROUP VII

A reading of the rejections of the claim of GROUP VII reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP VII.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 70 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a *prima facie* case of anticipation with respect to Claim 70 for at least the reasons provided with respect to Keller in Section 1.3 above (discussing Claim 26). Namely, Keller does not teach or suggest allowing a player to eliminate at least one random outcome, and in fact **requires** a player to have a hand, which in the Keller system is one of the "most important events."

In addition, Keller does not allow a player to select one of whether to receive a hand or to request a specific entry, as provided for in Claim 70. The Examiner has never addressed this feature of Claim 70.

Thus, Keller is devoid of any hint or suggestion of allowing a *player to select requesting a specific entry instead of selecting to receive a hand* (emphasis added).

7.4. No Prima Facie Showing of Indefiniteness of the Claim of Group VII

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP VII, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP VII does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP VII as indefinite under § 112 (2).

The Examiner asserts that "receiving a request" is indefinite because it is recited previously in the alternative. [Second Final Office Action, page 3]. This assertion does not make any sense. The player is clearly allowed to select one of the proffered options. Claim 70 merely recites a process in which the player elects the option to request a specific entry. There is no lack of clarity in reciting the availability of both options, even if only one is exercised.

The Examiner asserts that *a hand of a dealer* is "inferential." [Second Final Office Action, page 3]. As discussed in Section 1.5.8 above, however, the Examiner's Inferential Standard has no basis in law. The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having ordinary skill in the art would readily appreciate how a hand of a player may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

Regarding the Examiner's comments regarding use of "game of blackjack," the breadth of a claim is not to be equated with indefiniteness. See Moore. The Examiner's Breadth is

Indefiniteness Standard has no basis in law, as discussed in Section 1.5.6 above. That many variations may be known fatally undercuts the Examiner's argument that the scope of the term is not clear. See Robins.

To the extent the Examiner intended to reject Claim 70 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 70 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

8. GROUP VIII

GROUP VIII includes independent Claim 72.

The rejection of the claims of GROUP VIII is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP VIII.

Specifically, the Examiner has not shown that any claim of GROUP VIII can be deemed to be indefinite or anticipated by the cited references.

8.1. Independent Claim 72

Independent Claim 72 is directed to a method. The method comprises allowing a player of a game of blackjack to select one of: (i) allowing a dealer to receive a hand comprising at least one card, and (ii) requesting a specific entry.

The method further includes receiving a request from the player, the request indicating a specific score. A player score is determined based on a hand of a player, and an outcome of the game is determined based on the specific score and the player score.

8.2. Advantages of Independent Claim 72

The embodiment of Claim 72 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

In general, the method of Claim 72 is advantageous for the same reasons as independent Claim 56, discussed in Section 6.2 above.

In Claim 72, the player is expressly allowed to select either allowing a dealer to receive a hand or requesting a specific entry. Claim 72 is further advantageous in *receiving a request from a player that indicates a specific score*. The advantages of this type of *a specific score* are discussed with respect to Claim 27 in Section 2.2 above.

The winners of some types of games (e.g., blackjack) may be determined conventionally based on comparison of a hand of a player and a hand of a dealer. The method of Claim 72 is further advantageous in that it provides for *determining an outcome of the game based on the specific score and a player score*. Thus, *determining an outcome* in this manner allows for an entity (e.g., a casino) to take into account (a) *the specific score* (e.g., "18") *selected by a player instead of allowing a dealer to receive a hand*, and (b) *the player score*.

8.3. No Prima Facie Showing of Anticipation of the Claim of GROUP VIII

A reading of the rejections of the claim of GROUP VIII reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP VIII.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 72 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a *prima facie* case of anticipation with respect to Claim 72 for at least the reasons provided with respect to Keller in Section 2.3 above (discussing Claim 27). Namely, Keller does not teach or suggest eliminating at least one random outcome of a game, and a dealer's hand is one of "the most important events" in play of the Keller system.

Thus, Keller is devoid of any hint or suggestion of allowing a *player to select to request a specific score instead of allowing a dealer to receive a hand* (emphasis added).

8.4. No Prima Facie Showing of Indefiniteness of the Claim of Group VIII

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP VIII, when read in light of the specification, would not reasonably apprise

those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP VIII does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP VIII as indefinite under § 112 (2).

Regarding claim 72, the Examiner states the same reasons provided in support of the rejection of Claim 70. Appellants dispute these arguments in Section 7.4 above.

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 72 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

9. GROUP IX

GROUP IX includes dependent Claim 46.

The rejection of the claims of GROUP IX is flawed because the Examiner has not made a *prima facie* case of unpatentability of any claim of GROUP IX.

Specifically, the Examiner has not shown that any claim of GROUP IX can be deemed to be indefinite or anticipated by the cited references.

9.1. Independent Claim 46

Independent Claim 46 is directed to a method. In addition to the features of independent Claim 42 discussed above, it includes receiving a request in a manner comprising receiving a betting chip in a betting chip placement area.

9.2. Advantages of Independent Claim 46

The embodiment of Claim 46 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

These advantages are described above with respect to Claim 42.

9.3. No Prima Facie Showing of Anticipation of the Claim of GROUP IX

A reading of the rejections of the claim of GROUP IX reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP IX.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 46 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a prima facie case of anticipation with respect to Claim 46 for at least the reasons provided with respect to Claim 42, as discussed in Section 5.3 above.

9.4. No Prima Facie Showing of Indefiniteness of the Claim of Group IX

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP IX, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP IX does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP IX as indefinite under § 112 (2).

Regarding claim 46, the Examiner states that claim 46 "is inferential since a 'chip placement area' implies a table surface which has not been set forth" and requires "physical steps" to defined how a score may be represented by a game piece. [Second Final Office Action, pages 2-3].

While a table surface may be one type of a chip placement area, Applicants respectfully submit that there is nothing "inferential" about use of the broader term "chip placement area". There is certainly nothing unclear about what a chip placement area is. [See, e.g., Specification, page 11; FIG. 5].

As discussed in Section 1.5.8 above, however, the Examiner's Inferential Standard has no basis in law. The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having ordinary skill in the art would readily appreciate how a hand of a dealer may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

To the extent the Examiner intended to reject Claim 46 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 46 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

10. GROUP X

GROUP X includes dependent Claims **50 and 52**.

The rejection of the claims of GROUP X is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP X.

Specifically, the Examiner has not shown that any claim of GROUP X can be deemed to be indefinite or anticipated by the cited references.

10.1. Independent Claim 50

Dependent Claims **50 and 52** are directed to a method and are each dependent from independent Claim **42**.

Claim **50** includes a feature of *adjusting a bet for the game*.

Claim **52** includes a feature of *adjusting a payout for the game*.

To the extent that both claims stand rejected under § 112 (2) for use of the word adjusting in an allegedly unclear manner, the claims stand and fall together.

Claim **50** is representative.

10.2. Advantages of Independent Claim 50

The embodiment of Claim **50** provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

These advantages are described above with respect to Claim **42**.

10.3. No Prima Facie Showing of Anticipation of the Claim of GROUP X

A reading of the rejections of the claim of GROUP X reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not

GROUP X

disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP X.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim **50** only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a *prima facie* case of anticipation with respect to Claim **50** for at least the reasons provided with respect to Claim **42**, as discussed in Section 5.3 above.

10.4. No Prima Facie Showing of Indefiniteness of the Claim of Group X

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP X, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP X does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP X as indefinite under § 112 (2).

Regarding claim **50**, the Examiner states that “the steps required” for adjusting are not clear. [Second Final Office Action, page 3].

The Examiner has previously been referred to page 9, line 14 – page 10, line 23 of Applicants' specification. As understood by Appellants, as discussed herein, the Examiner refuses to consider the Specification. This is contrary to law.

Further, as discussed in Section 1.5.8 above, however, the Examiner's Inferential Standard has no basis in law, and Appellants have no obligation to recite steps that only the Examiner believes are “required.” The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having

ordinary skill in the art would readily appreciate how a hand of a dealer may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

To the extent the Examiner intended to reject Claim 50 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 50 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

SEPARATE ARGUMENT OF PATENTABILITY

11. GROUP XI

GROUP XI includes dependent Claims 64-66.

The rejection of the claims of GROUP XI is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of GROUP XI.

Specifically, the Examiner has not shown that any claim of GROUP XI can be deemed to be indefinite or anticipated by the cited references.

11.1. Independent Claim 64

Dependent Claims 64-66 are directed to a method and are each dependent from independent Claim 56.

Claim 64 includes a feature of *adjusting a bet for the game*.

To the extent that the claims stand rejected under § 112 (2) for use of the word “adjusting” in an allegedly unclear manner, the claims stand and fall together.

Claim 50 is representative.

11.2. Advantages of Independent Claim 64

The embodiment of Claim 64 provides several advantages not even disclosed or suggested, much less recognized, by the prior art of record (either alone or in combination).

These advantages are described above with respect to Claim 56.

11.3. No Prima Facie Showing of Anticipation of the Claim of GROUP XI

A reading of the rejections of the claim of GROUP XI reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not

disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of the claim of GROUP XI.

The proper legal standards for anticipation are included in Section 1.3 above.

The Examiner has rejected Claim 64 only in light of the Keller reference.

Appellants submit that the Examiner has failed to establish a *prima facie* case of anticipation with respect to Claim 64 for at least the reasons provided with respect to Claim 56, as discussed in Section 5.3 above.

11.4. No Prima Facie Showing of Indefiniteness of the Claim of Group XI

The Examiner has not satisfied the initial burden of proof by establishing either (i) that the claim of GROUP XI, when read in light of the specification, would not reasonably apprise those skilled in the relevant art of the scope of the invention, or (ii) that the claim of GROUP XI does not claim what Applicants regard as their invention.

The Examiner thus has not provided any proper legal basis for rejecting the claim of GROUP XI as indefinite under § 112 (2).

Regarding claim 64, the Examiner states that “the steps required” for adjusting are not clear. [Second Final Office Action, page 3].

The Examiner has previously been referred to page 9, line 14 – page 10, line 23 of Applicants' specification. As understood by Appellants, as discussed herein, the Examiner refuses to consider the Specification. This is contrary to law.

Further, as discussed in Section 1.5.8 above, however, the Examiner's Inferential Standard has no basis in law, and Appellants have no obligation to recite steps that only the Examiner believes are “required.” The Examiner is merely requiring that Appellants recite more detailed steps to explain how a hand may be determined, even though one having

ordinary skill in the art would readily appreciate how a hand of a dealer may be determined. That is not the role of claims. A claim need not provide a written description of the invention.

To the extent the Examiner intended to reject Claim 64 as not being what Appellants regard as their invention, Appellants dispute any such implication. No finding has been made to support such a rejection under § 112 (2).

Accordingly, the Examiner has failed to establish a *prima facie* case of indefiniteness under § 112 (2).

No finding has been made that Claim 64 is broader than afforded by Appellants' disclosure. See arguments made in Section 1.5.10 above.

CONCLUSION

Thus, the Examiner's rejection of the pending claims is improper at least because the Examiner has not provided a proper legal basis for rejecting any claim as non-statutory. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Michael Downs using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

March 29, 2004

Date



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APPENDIX A
CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

Claims 26, 27, and 38-72 are being appealed.

Claims 26, 27, 38, 40, 42, 56, 70, and 72 are independent.

26. (PREVIOUSLY PRESENTED) A method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner, comprising:

allowing a player to select a specific score instead of a player's hand;

dealing and playing a dealer's hand; and

comparing the specific score to the dealer's hand and the predetermined point total to determine a winner of the game.

27. (PREVIOUSLY PRESENTED) A method of playing a game having a game outcome that depends at least in part on a predetermined point total, in which a hand of a player is compared to a hand of a dealer to determine a winner, comprising:

allowing a player to select a specific score instead of a dealer's hand;

dealing and playing a player's hand; and

comparing the player's hand to the specific score to determine a winner of the game.

38. (PREVIOUSLY PRESENTED) A method comprising:

receiving a wager for a game from a player,

in which the game has a game outcome that depends at least in part on a predetermined count value, and

in which a rule of the game provides that the player may receive at least one card determined by chance;

receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card;

determining a dealer score based on a hand of a dealer; and

determining an outcome of the game based on the predetermined count value, the specific entry, and the dealer score.

39. (PREVIOUSLY PRESENTED) The method of claim 38, in which the game is blackjack.

40. (PREVIOUSLY PRESENTED) A method comprising:

receiving a wager for a game from a player,

in which the game has a game outcome that depends at least in part on a predetermined count value, and

in which a rule of the game provides that a dealer may receive at least one card determined by chance;

receiving a request from the player for a specific entry, in which the specific entry is in place of the at least one card;

determining a player score based on a hand of the player; and

determining an outcome of the game based on the predetermined count value, the specific entry, and the player score.

41. (PREVIOUSLY PRESENTED) The method of claim 40, in which the game is blackjack.

42. (PREVIOUSLY PRESENTED) A method comprising:

receiving a request from a player, the request indicating a specific score to be used in place of a hand of the player;

determining a hand of a dealer; and

comparing the specific score and the hand of the dealer to determine a winner of a game of twenty-one.

43. (PREVIOUSLY PRESENTED) The method of claim 42, in which determining the hand of the dealer comprises:

dealing at least one card of a plurality of cards to the dealer.

44. (PREVIOUSLY PRESENTED) The method of claim 43, in which the player does not receive any of the plurality of cards.

45. (PREVIOUSLY PRESENTED) The method of claim 42, in which the specific score is one of 17, 18, 19 and 20.

46. (PREVIOUSLY PRESENTED) The method of claim 42, in which receiving the request comprises:

receiving a betting chip in a betting chip placement area.

47. (PREVIOUSLY PRESENTED) The method of claim 42, in which the specific score is represented by a game piece.

48. (PREVIOUSLY PRESENTED) The method of claim 42, in which receiving the request comprises:

receiving the request at a video game device.

49. (PREVIOUSLY PRESENTED) The method of claim 42, in which receiving the request comprises:

receiving the request via the Internet.

50. (PREVIOUSLY PRESENTED) The method of claim 42, further comprising:
adjusting a bet for the game.
51. (PREVIOUSLY PRESENTED) The method of claim 50, further comprising:
notifying the player of the adjustment of the bet.
52. (PREVIOUSLY PRESENTED) The method of claim 42, further comprising:
adjusting a payout for the game.
53. (PREVIOUSLY PRESENTED) The method of claim 52, further comprising:
notifying the player of the adjustment of the payout.
54. (PREVIOUSLY PRESENTED) The method of claim 42, in which determining the hand
of the dealer comprises:
determining a probability based on the request; and
determining the hand of the dealer based on the probability.
55. (PREVIOUSLY PRESENTED) The method of claim 42, in which comparing
comprises:
determining a score corresponding to the hand of the dealer; and
determining which of the specific score and the score corresponding to the hand of the
dealer is greater.
56. (PREVIOUSLY PRESENTED) A method comprising:
receiving a request from a player, the request indicating a specific score to be used in
place of a hand of a dealer;
determining a hand of the player; and

comparing the specific score and the hand of the player to determine a winner of a game of twenty-one.

57. (PREVIOUSLY PRESENTED) The method of claim 56, in which determining the hand of the player comprises:

dealing at least one card of a plurality of cards to the player.

58. (PREVIOUSLY PRESENTED) The method of claim 57, in which the dealer does not receive any of the plurality of cards.

59. (PREVIOUSLY PRESENTED) The method of claim 56, in which the specific score is one of 17, 18, 19 and 20.

60. (PREVIOUSLY PRESENTED) The method of claim 56, in which receiving the request comprises:

receiving a betting chip in a betting chip placement area.

61. (PREVIOUSLY PRESENTED) The method of claim 56, in which the specific score is represented by a game piece.

62. (PREVIOUSLY PRESENTED) The method of claim 56, in which receiving the request comprises:

receiving the request at a video game device.

63. (PREVIOUSLY PRESENTED) The method of claim 56, in which receiving the request comprises:

receiving the request via the Internet.

64. (PREVIOUSLY PRESENTED) The method of claim 56, further comprising:
adjusting a bet for the game.
65. (PREVIOUSLY PRESENTED) The method of claim 64, further comprising:
notifying the player of the adjustment of the bet.
66. (PREVIOUSLY PRESENTED) The method of claim 56, further comprising:
adjusting a payout for the game.
67. (PREVIOUSLY PRESENTED) The method of claim 66, further comprising:
notifying the player of the adjustment of the payout.
68. (PREVIOUSLY PRESENTED) The method of claim 56, in which determining the hand
of the player comprises:
determining a probability based on the request; and
determining the hand of the player based on the probability.
69. (PREVIOUSLY PRESENTED) The method of claim 56, in which comparing
comprises:
determining a score corresponding to the hand of the player; and
determining which of the specific score and the score corresponding to the hand of the
player is greater.
70. (PREVIOUSLY PRESENTED) A method comprising:
allowing a player of a game of blackjack to select one of:
receiving a hand comprising at least one card, and
requesting a specific entry;
receiving a request from the player, the request indicating a specific score;

determining a dealer score based on a hand of a dealer; and
determining an outcome of the game based on the specific score and the dealer score.

71. (PREVIOUSLY PRESENTED) The method of claim 70,
in which receiving the request comprises:
receiving a chip that indicates the specific score; and
in which the specific score is one of 17, 18, 19 and 20.
72. (PREVIOUSLY PRESENTED) A method comprising:
allowing a player of a game of blackjack to select one of:
allowing a dealer to receive a hand comprising at least one card, and
requesting a specific entry;
receiving a request from the player, the request indicating a specific score;
determining a player score based on a hand of the player; and
determining an outcome of the game based on the specific score and the player score.